

PATENT
P56332

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF APPEALS AND INTERFERENCES

In re Application of:

Appeal No. _____

SHIGEHARU NAKAGAWA

Serial No.: 09/874,010

Examiner: TIMOTHY M. BROWN

Filed: 6 June 2001

Art Unit: 1648

For: APPARATUS AND TECHNIQUE FOR ON-DEMAND PRINTING, AND ON-DEMAND PRINTING SERVICES

TRANSMITTAL OF APPELLANT'S BRIEF FEE

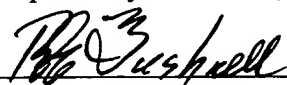
Mail Stop Appeal Brief-Patents

Commissioner for Patents
P.O.Box 1450
Alexandria, VA 22313-1450

Sir:

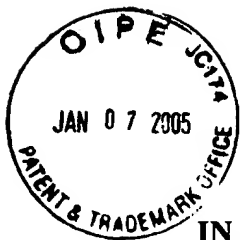
Accompanying this transmittal is a check drawn to the Commissioner of Patents & Trademarks in the total amount of \$475.00 (Check #48591) for the filing an Appeal Brief in support of a Notice of Appeal filed on 30 September 2004, together with a Petition for a two-month extension of time (SMALL ENTITY) which extends the period for filing a Brief to and through 30 January 2005. Should the check become lost, be deficient in payment, or should other fees be incurred, the Commissioner is authorized to charge Deposit Account No. 02-4943 of Applicant's undersigned attorney in the amount of such fees.

Respectfully submitted,


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Folio: P56332
Date: 7 January 2005
I.D.: REB/kf



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For: APPARATUS AND TECHNIQUE FOR ON-DEMAND PRINTING, AND ON-DEMAND PRINTING SERVICES

APPEAL BRIEF

Paper No. 23

Mail Stop Appeal Brief-Patents

Commissioner for Patents

P.O.Box 1450

Alexandria, VA 22313-1450

Sir:

Pursuant to Appellant's Notice of Appeal filed on the 30th of September 2004, Appellant hereby appeals to the Board of Patent Appeals and Interferences from the final rejection of claims 38 through 81, as set forth in the final Office action mailed on the 30th of March 2004 (Paper No. 18) and in the Advisory Action mailed on the 22nd of December 2004 (Paper No. 20041214). The period for filing an Appeal Brief is being extended by a Petition for extension of time (Paper No. 24) concurrently submitted herewith.

Folio: P56332

Date: 1/7/05

I.D.: REB/kf

I. REAL PARTY IN INTEREST

Pursuant to 37 CFR §41.37(c)(1)(i) as amended, the real party in interest is:

TRY-EX
4-5-17, Hondori,
Kure, Hiroshima, Japan 737-0045

as evidenced by the Assignment executed by the inventor on 6 June 2001 and recorded by the US Patent and Trademark Office on the 21st of June 2001 at Reel 011920, Frame 0702.

II. RELATED APPEALS AND INTERFERENCES

In conformance with 37 CFR §41.37(c)(1)(ii), there are no other appeals and no interferences known to Appellant, Appellant's legal representatives or the assignee which will directly affect, be directly affected by, or have a bearing on the Board's decision in the pending appeal.

III. STATUS OF CLAIMS

Pursuant to 37 CFR §41.37(c)(1)(iii), claims 1 through 37 have been canceled. Claims 38 through 81 are on appeal.

IV. COPY OF CLAIMS

In compliance with 37 CFR §41.37(c)(1)(viii), a copy of the claims involved in this appeal are contained in the Appendix.

V. STATUS OF AMENDMENTS

Pursuant to 37 CFR §41.37(c)(1)(iv), no Amendment was filed subsequent to the final Office action mailed on 30 March 2004 (Paper No. 18).

VI. SUMMARY OF CLAIMED SUBJECT MATTER

The Network's Circuit

Pursuant to 37 CFR §41.37(c)(1), Figures 1 and 2 illustrate details of a network printing service that can be accessed via the Internet. On-demand printing support device 1 may be constructed with homepage provider 1a for providing a homepage (*i.e.*, the content information provided by the World Wide Web (WWW) server) and file management device 1b for controlling a document comprised of text, images and pictures provided by the customer via user terminal 2.¹ Homepage provider 1a may use homepage contents 11, contents server 12 and printing information database 13 for storing documents having text, images and pictures, while file management device 1b may use file management server 14, database 15 for storing a finalized document including its associated text, images and pictures, controlled information database 16 and output controller 17. Homepage contents server 11 records homepage information provided by the homepage provider 1 to customers via the user's terminal 2.²

Contents server 12 enables the user's terminal 2 and/or editor 4 to input information

¹ Specification, paragraph [0034].

² Specification, paragraph [0034].

based on the instructions recorded in homepage contents 11, and sends messages and information to the user's terminal 2 and/or editor 4. Printing information database 13 records, according to the ID number of the customer who uses terminal 2, a document having text, images and pictures input by the customer through the user's terminal 2 via computer network 3 in accordance with the instructions given by contents server 12.³

File management server 14 enables file management device 1b to record the document received from the user, together with its associated text, images and pictures retrieved by editor 4 from printing information database 13 via contents server 12 and edited by editor 4 as a finalized document containing text, images and pictures, and controlled information as a controlled file. The finalized document and its text, images and pictures, is stored in finished manuscript database 15 records as controlled files, the finished documents and their text, images and pictures received from editor 4.⁴

Output controller 17 controls transmission of the finalized document and its text, images and pictures output to output device 5.⁵

Estimate Of Customer's Cost

An input device and a display device, *etc.* (not shown in the figures) are connected as peripheral devices to on-demand printing supporting device 1 through the user's terminal 2.

³ Specification, paragraph [0035].

⁴ Specification, paragraph [0036].

⁵ Specification, paragraph [0036].

Here, a keyboard, a mouse, *etc.* are used as the input devices.⁶ In step S1, content server 12 requests ⁷ the customer at terminal 2 to initiate, through customer terminal 2, a cost estimate request; in step S4, the cost estimate request is conveyed to on-demand printing supporting device 1 when the customer makes a selection from the menu posted on the homepage provided by server 12.⁸

Content server 12 displays in the customer's terminal 2, an input operational screen,⁹ notifies the customer who is using terminal 2 of menu selection necessary to obtain the cost estimate (S2), and in step S3 requests the customer at terminal 2 to actually make the selection in accordance with the displayed instructions.¹⁰ Server 12 also displays the selections which are available for a document that has text, images and pictures in a certain format.¹¹ This information represents the printed products which may be manufactured from a document and its text, images and pictures, through output device 5. The selection is made when the user designates the various attributes¹² such as paper size, number of pages, type of binding, if any, (*e.g.*, binding by stapler, by binder, or by wrapper), whether or not a cover is to be present, type

⁶ Specification, paragraph [0037].

⁷ Illustrated by Figure 2.

⁸ Specification, paragraph [0038].

⁹ Illustrated in the Drawings, Figure 4.

¹⁰ The instructions entitled "1. Estimation" shown in Figure 3.

¹¹ Illustrated in the Drawings, Figure 4.

¹² An example of one set of attributes that may be supplied by a user via terminal 2, is illustrated by Figure 5.

of recording media, (*e.g.*, printing by color sheet of fine quality (or super-thick type), color sheet of fine quality), number of copies, name and e-mail address for notifying the user of the estimate of cost.¹³ A second form requesting further information from the customer may then be displayed. This form can include, but is not limited to, soliciting from the user a selection of the color of paper to be used in the printing process, designation of the location where the customer wants the document or manuscript to be printed, selection of the type of output device which the customer desired to manufacture his document or manuscript (*e.g.*, such as toner type digital printer, CD-ROM printing device, ink-jet type printer or magnetic optical disk read/write device), and selection of such attributes of the printed product as enlargement or reduction information for images and/or pictures, font type, font size, page margins, line spacing, page numbering, justification, printing on one side of a piece of paper or printing in duplex. All of this information is sent to the on-demand printing supporting device 1 when the user clicks the "submit button" as shown in Figure 4.¹⁴

When these selections have been made, server 12 notifies editor 4 that the request for an estimate of cost has been received during step S4. Editor 4 is notified of the receipt of the request, and in step S5 editor 4 makes an estimate of the cost to be charged to the customer for manufacturing the documents specified by the customer.¹⁵ The estimate of cost made by editor 4 then is sent during step S6, to the customer's terminal 2 from editor terminal 4 via contents

¹³ An example of a complete estimate of cost based upon the attributes is listed in Figure 4.

¹⁴ Specification, paragraph [0039].

¹⁵ Illustrated by Figure 6.

server 12, such as in the form of e-mail.¹⁶ The e-mail containing the cost estimate made by editor 4 also contains a customer ID and a customer password which are necessary for the customer using terminal 2 to access the document and its text, images and pictures located in contents server 12.¹⁷

Post Estimate Of Cost Activity: Submission Of Customer's Order

Upon receipt of the estimated cost,¹⁸ client ID and client password, the customer using terminal 2 in step S7 places one, or more orders that will accompany the customer's submission of a document such as a manuscript containing, among other properties, text, images and pictures (log into printing service) by selecting the "2. Data Submission" menu on the homepage¹⁹ provided by contents server 12.²⁰ In step S8, contents server 12 displays on the customer's terminal, a log-in screen²¹ and operational panel for connecting the customer's terminal to contents server 12. The customer 2 then inputs the client ID and client password previously received.²² The customer's terminal then is connected to the document handler and

¹⁶ Drawings, Figure 6.

¹⁷ Specification, paragraph [0040].

¹⁸ Illustrated by Figure 6.

¹⁹ Selection "2." shown in Figure 3.

²⁰ Illustrated by Figure 3.

²¹ Illustrated by Figure 7.

²² Illustrated by Figure 7.

editor 4 by depressing the “log-in” button in step S9.²³ Contents server 12 then, in step S10, displays on the customer's terminal 2 an input screen for inputting the manuscript document and its text, images and pictures.²⁴ The customer at terminal 2 then selects an appropriate document together with its text, images and pictures, that is displayed in a certain data format on the customer's terminal 2 by depressing the “reference button” under “file directory” on the screen.²⁵ The manuscript document, and its text, images and pictures, is then transmitted to contents server 12 when the “upload” button on the screen is toggled in step S11.²⁶ Here, either PDF (Portable Document Format) which displays the same image on the customer's terminal can be used to present the printing material, or the markup language, html (Hyper Text Markup Language), are preferable as a data format for the manuscript document and its text, images and pictures.²⁷

Contents server 12 stores the manuscript document and its text, images and pictures, together with the customer's client ID, in printing information database 13, and then in step S12 notifies editor 4 that the document and its text, images and pictures have been received.²⁸ Receipt of a document and its text, images and pictures can be found by editor 4 either by

²³ Illustrated by Figure 7.

²⁴ Drawings, Figure 2 and Figure 8.

²⁵ Drawings, Figure 8.

²⁶ Illustrated by Figure 8.

²⁷ Specification, paragraph [0041].

²⁸ Illustrated by Figure 9.

periodically accessing contents server 12, or by contents server 12 notifies editor 4 upon receipt of manuscript document. Editor 4 then, in step S13, retrieves the manuscript document from printing information database 13 via contents server 12.²⁹

This implementation provides a price quote to a customer and allows the customer to selectively accept the charges or to rescind the transaction before the customer commits to transmission of the manuscript document and to having the print job executed by the printing service,³⁰ and enables the customer to easily make subsequent changes to a document submitted to the printing service for printing.³¹ Through its use of the Internet and network printing, this printing service can continuously accommodate many customers at many different locations simultaneously.³²

Post Estimate Of Cost Activity: Editing Of Customer's Submission

Editor 4 retrieves the manuscript documents, and their text, images and pictures via contents server 12.³³ Figure 10 also illustrates a "Download" button for retrieving the document having text, images and pictures, a "Delete" button for deleting the document having text, images and pictures from the printing information database, as well as a list of uploaded document information. In Figure 10, "To" stands for an address where the document having

²⁹ Specification, paragraph [0042].

³⁰ Specification, paragraph [0015].

³¹ Specification, paragraph [0017].

³² Specification, paragraph [0018].

³³ Illustrated by Figure 10.

text, images and pictures has sent (from contents server 12), “Real Name” stands for the type of the document sent or received, and “Upload Time” stands for a time period for uploading the document, Editor 4 then downloads the documents and their text, images and pictures necessary in accordance with the instructions set forth on the operation panel. The process of editing may include changes made to the document at the request of the customer, or may include changes initiated by the print agency itself. Editing can include, but is not limited to, correction of misspellings, correction of typographical errors, correction of unreadable characters that can be caused by different computer software programs used by the customer and the print agency or different font environments, and formatting production aspects of the document such as page margins, page numbering, line numbering, paragraph numbering, line spacing, insertion of headers and footers, change of fonts or font size, enlargement or reduction of a size of an image or picture, formatting equations.³⁴

Post Estimate-Of-Cost Activity: Revision, Proofreading And Re-submission By The Customer

The edited document and its text, images and pictures is stored in file management server 14 by editor 4, and sent by editor 4, in step S14-2, to the customer for revision by the customer or to be proofread. In step S14-3, the customer is able to resubmit the proofread document to the print agency (S14-4), and then a second editing may be performed by editor 4 (S14-5). If no subsequent editing is necessary, the finalized document, together with its text, images and

³⁴ Specification, paragraph [0043].

pictures received by editor 4 may be sent to finalized document database 15 from printing information database 13 as a finalized document.³⁵

Post Estimate-Of-Cost Activity: Manufacture And Delivery Of Finalized Document

File management server 14 receives from editor 4 controlled printing information is a control file, for controlling the processing of an edited document, and records that information in controlled (or management) information database 16 (S16). Figure 11 illustrates typical contents of a control file created by editor 4. This control file specifies whether the manufactured finished document will be a bound print, the name of the sales person, and information on the customer (category and name), date when complete manuscript information was made, name and parts/reference number of the complete manuscript file, the language used in complete manuscript information, number of pages, price per page, size of the print copy, quality of a cover, paper quality of the text, print information on the cover, text print information, print color of the cover, binding style, binding method, name of support staff, data form of the manuscript (kind of the manuscript), control number of the recording medium (*e.g.* an optical magnetic disk such as MO *etc.* and a tape) which records complete manuscript information in electronic data format, *etc.*³⁶

After file management server 14 has recorded a complete document, together with its text, images and pictures in finalized document database 15, and has recorded a control file in

³⁵ Specification, paragraph [0044].

³⁶ Specification, paragraph [0045].

controlled information database 16, editor 4 gives instructions (S17) to output controller 17 to transmit the finalized edited document to output device 5 (S18). At this point, when output device 5 includes a plurality of devices, (e.g. toner digital printer 51, CD-ROM printing device 52, ink-jet printer 53, magneto-optical disk read/write device 54, etc.), editor 4 selects an appropriate output device.³⁷ Then, output device 5 records the finalized document on the recording medium desired by the customer (for example, a printed and bound product or a CD-ROM) (S19). In step S20, the manufactured documents will be delivered to the customer via mail, private home delivery services, etc.³⁸

VII. REFERENCES OF RECORD

U.S. Patents

- Farros, U.S. Patent No. 5,930,810
- Goldberg *et al.*, U.S. Patent No. 6,196,146

Other References

- Internet article entitled *E-Business 100 iPrint: Self-Service Printing* by Eric Chabrow, published on the 13th of December 1999 in *Information Week OnLine*.
- *PR Newswire* press release entitled *New Internet Standard Approved To Streamline Process For Editing Documents On Web* published on the 9th of December 1998.

³⁷ Specification, paragraph [0046].

³⁸ Specification, paragraph [0047].

VII. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

1. Rejection of Claims 64, 66, 72 and 73 Under 35 U.S.C. §103(a)

Claims 64, 66, 72 and 73 are rejected under 35 U.S.C. §103(a) as rendered obvious, and unpatentable, over the Examiner's proposed combination of the Internet article entitled *E-Business 100 iPrint: Self-Service Printing* by Eric Chabrow, published on the 13th of December 1999 in *Information Week OnLine*, modified according to the PR Newswire press release.

2. Rejection of Claims 65 and 68 Under 35 U.S.C. §103(a)

Claims 65 and 68 are rejected under 35 U.S.C. §103(a) as rendered obvious, and unpatentable, over the Examiner's proposed combination of the Internet article entitled *E-Business 100 iPrint: Self-Service Printing* by Eric Chabrow, published on the 13th of December 1999 in *Information Week OnLine*, modified in view of the PR Newswire press release and Farros '810.

3. Rejection of Claims 67 and 74 Under 35 U.S.C. §103(a)

Claims 67 and 74 are rejected under 35 U.S.C. §103(a) as rendered obvious, and unpatentable, over the Examiner's proposed combination of the Internet article entitled *E-Business 100 iPrint: Self-Service Printing* by Eric Chabrow, published on the 13th of December 1999 in *Information Week OnLine* modified in view of the PR Newswire press release, and the Examiner's Official Notice.

4. Rejection of Claims 75-81 Under 35 U.S.C. §103(a)

Claims 75 through 81 are rejected under 35 U.S.C. §103(a) as rendered obvious, and unpatentable, over the Examiner's proposed combination of the Internet article entitled *E-*

Business 100 iPrint: Self-Service Printing by Eric Chabrow, published on the 13th of December 1999 in *Information Week OnLine*, modified according to the PR Newswire press release, Goldberg '146, and the Examiner's Official Notice of various items, although some of those items were inexplicably not constituent components of the rejected claims.

5. **Rejection of Claims 38-44 Under 35 U.S.C. §103(a)**

Claims 38 through 44 are rejected under 35 U.S.C. §103(a) as rendered obvious, and unpatentable, over the Examiner's proposed combination of Goldberg *et al.*, U.S. Patent No. 6,196,146, modified according to the PR Newswire press release entitled *New Internet Standard Approved To Streamline Process For Editing Documents On Web* published on the 9th of December 1998, the Internet article entitled *E-Business 100 iPrint: Self-Service Printing* by Eric Chabrow, published on the 13th of December 1999 in *Information Week OnLine*, and what the Examiner asserts is "Official Notice" of five (5) distinct features of Appellant's claims.

6. **Rejection Of Claims 39-42 And 44 Under 35 U.S.C. §103(a)**

Claims 39 through 42 and 44 were rejected under 35 U.S.C. §103(a) as rendered obvious, and unpatentable, over the Examiner's proposed combination of Goldberg '146, modified according to Chabrow, the PR Newswire article and the Examiner's litany of Official Notice of five (5) distinct features of Appellant's claims.

7. **Rejection of Claims 45, 46, 52 and 71 Under 35 U.S.C. §103(a)**

Claims 45, 46, 52 and 71 are rejected under 35 U.S.C. §103(a) as rendered obvious and unpatentable over the Examiner's proposed combination of Farros, U.S. Patent No. 5,930,810, modified according to Goldberg '146 and the PR Newswire press release.

8. **Rejection of Claims 47-51 Under 35 U.S.C. §103(a)**

Claims 47 through 51 are rejected under 35 U.S.C. §103(a) as rendered obvious, and unpatentable over the Examiner's proposed combination of Farros '810 modified according to Goldberg '146 and what the Examiner identified as "Official Notice."

9. **Rejection of Claim 53 Under 35 U.S.C. §103(a)**

Claim 53 are rejected under 35 U.S.C. §103(a) as rendered obvious, and unpatentable, over the Examiner's proposed combination of Farros '810 modified according to Goldberg '146, the PR Newswire press release, and the Internet article entitled *E-Business 100 iPrint: Self-Service Printing* by Eric Chabrow, published on the 13th of December 1999 in *Information Week OnLine*.

10. **Rejection of Claims 55-57, 60-62, 69 and 70 Under 35 U.S.C. §103(a)**

Claims 55 through 57, 60 through 62, 69 and 70 are rejected under 35 U.S.C. §103(a) as rendered obvious, and unpatentable over the Examiner's proposed combination of Farros '810, modified according to the Examiner's Official Notice and the PR Newswire press release.

11. **Rejection of Claims 58, 59 and 63 Under 35 U.S.C. §103(a)**

Claims 58, 59 and 63 are rejected under 35 U.S.C. §103(a) as rendered obvious, and unpatentable, over the Examiner's proposed combination of Farros '810, modified according to the Examiner's Official Notice, the PR Newswire press release, and the Internet article entitled *E-Business 100 iPrint: Self-Service Printing* by Eric Chabrow, published on the 13th of December 1999 in *Information Week OnLine*.

IX. ARGUMENT

Rejection of Claims 64, 66, 72 and 73 Under 35 U.S.C. §103(a)

Claims 64, 66, 72 and 73 are rejected under 35 U.S.C. §103(a) for alleged unpatentability over the Examiner's proposed combination of the Internet article entitled *E-Business 100 iPrint: Self-Service Printing* by Eric Chabrow, published on the 13th of December 1999 in *Information Week OnLine*, modified in view of the PR Newswire press release, modified in view of the PR Newswire press release entitled *New Internet Standard Approved To Streamline Process For Editing Documents On Web* published on the 9th of December 1998. On the record before the Board, this rejection may not be sustained.

A. The Record Of This Application Is Devoid Of The Requisite Evidence Of Motivation Necessary Under 35 U.S.C. §103(a) To Construct The Examiner's Proposed Combination.

Paper No. 29 admits that the,

“Chabrow does not expressly teach ‘said printing agency comprising an editor’ and ‘said printing agency *returning a first draft* of said document to the corresponding one of the users, and disposed to *generate a final draft* of said document *in response to reception of a revision of said first draft* from the corresponding one of the users.’”³⁹

Paper No. 29 then in leap of fiction made to circumvent 35 U.S.C. §103(a), states that,:

“PR Newswire teaches a system for collaboratively editing documents over the Internet ... [and] it would have been obvious ... to modify Farros [*sic*, Chabrow, the primary reference?] to include the teachings of *PR Newswire* would enable the printing agency to provide an additional layer of service wherein the

³⁹ Paper No. 29, page 31, emphasis added.

customer and printing agency collaborate to correct any print job errors that may be detected by the print agency.”⁴⁰

Not only does this piecemeal approach to examination fail to comply with 35 U.S.C. §103(a), but it ignores the absence of the motivation necessary to modify the primary reference.

The Examiner’s proposed combination is intrinsically lacking the motivation necessary to modify the primary reference in conformance with the Examiner’s assertion that “*PR Newswire* teaches a system for collaboratively editing documents over the Internet.”⁴¹ Chadbrow expressly teaches that:⁴²

“[r]educing prepress costs lets iPrint price products at 25% to 50% below retail. “If most orders didn’t go through untouched, it wouldn’t be possible to scale as fast as we are and deliver the prices we offer.”⁴³

Modifying Chadbrow to incorporate the “*PR Newswire* ... system for collaboratively editing documents over the Internet”⁴⁴ impermissibly prevents Chadbrow from operating in its intended

⁴⁰ Paper No. 29, page 31.

⁴¹ Paper No. 29, page 37.

⁴² Appellant questions the enablement attributed by Paper No. 29 to Chadbrow. Moreover, under what basis does Chabrow constitute *Prior Art* Under 35 U.S.C. §102(b)? The Eric Chabrow *InformationWeek*, ostensibly was published on or about the 13th of December 1999. Appellant’s claim for priority extends from the 13th of October 2000. There is no evidence of record establishing that Eric Chabrow reference is available as prior art under 35 U.S.C. §102(b) or (e), as a publication “more than one year prior to the date of the application for patenting in the United States.”

⁴³ Internet article entitled *E-Business 100 iPrint: Self-Service Printing* by Eric Chabrow, published on the 13th of December 1999 in *Information Week OnLine*.

⁴⁴ Paper No. 29, page 37.

mode by “[r]educing prepress costs” by “automat[-ing] the prepress process” through the expediency of having the orders of customers “go through untouched.” Consequently, the Examiner’s proposed combination is untenable and this rejection may not be sustained. Moreover, this deficiency in the Examiner’s proposed combination is irrefutable evidence of the non-obviousness of Appellant’s process.

B. The Examiner’s Proposed Combination Fails To Make a *Prima Facie* Showing of Obviousness Under 35 U.S.C. §103(a).

Chabrow does not expressly teach

“said printing agency comprising an editor” and “said printing agency returning a first draft of said document to the corresponding one of the users, and disposed to generate a final draft of said document in response to reception of a revision of said first draft from the corresponding one of the users.”

The Examiner relies upon the PR Newswire to remedy the deficiency of Chabrow and teach “independently of said printing agency.” The Examiner ignores however, that nothing in PR Newswire either uses a printing agency or the fact that incorporation of a printing agency into the PR Newswire interrupts the “distributed authoring and versioning process which enables Web users in distance locations “to write, edit and save shared documents without scuttling each other’s work.” Consequently, the Examiner’s proposed combination lacks Appellant’s “printing agency ... disposed to generate a *final draft* of said document in response to reception of a revision of said first draft from the corresponding one of the users.” In contradistinction, the Examiner’s proposed combination ostensibly generates a plurality of first drafts and is dedicated

to owning any generation of “a final draft ... in response to reception of all the revision from said first draft from the corresponding one of the users.”

Eric Chabrow pertains to an article in “Information Week” that discusses a website “www.iprint.com” that enables printing of images and/or text on a variety of media. www.iprint.com doesn’t do its own printing but transmits orders over the internet to commercial printers to be fulfilled. Like Farros ‘810, there is no editor at the place where the customer submits the document to provide professional services for the customer.

The Examiner’s reading of Chabrow is technically inaccurate. Chabrow states that it provides a process for “reducing prepress costs”, and discloses nothing more. This is the same “prepress process” disclosed in Fig. 7 of Farros ‘810, preceding the manufacturing of the product subsequent to step 728 of Farros ‘810. It is noteworthy that all of the “prepress process” is performed by the user, or customer, and that there is no editing performed either by Chabrow or by Farros ‘810. In short, the Examiner’s proposed combination is nothing more than disclosed by Farros ‘810, with the software allowing “customers [to] design, proofread and order personalized business cards, stationery, checks, rubber stamps, sticky notes, labels, and novelty gifts such as golf balls and coffee mugs [and to ... also] import graphics as well as adjust layouts, fonts, and ink colors to customize print products⁴⁵” via either a kiosk terminal or a personal computer terminal, in an entirely user controlled transaction extending from the user initiated prepress selection of the (1) “entry of textural information (personal information)” and

⁴⁵ Chabrow, 4th paragraph.

verification in step 1002,⁴⁶ of the (2) selection of “the quantities of each orderable product” in step 1004,⁴⁷ and the selection of the (3) product type,⁴⁸ (4) category of product,⁴⁹ (5) layout of the chosen category,⁵⁰ and designation of the attributes of the category in the plurality of options⁵¹ presented to the user in step 1006,⁵² to completion and submission of the order by the user in step 1012.⁵³ Neither taught nor suggested by Farros ‘810 is any division of labor made by Appellant’s claim 64; these tasks are preformed solely and entirely by the user in response to a plurality of templates and menus. Neither Chabrow nor Farros ‘810 disclose or suggest “an editor editing a manuscript submitted by a user” in combination with “returning said document to the user” and “receiving a revision of said document from the user, in combination with Appellant’s “server accessible via the Internet.”

The Examiner’s singular inability to contemplate the distinction between the software taught by the primary and secondary references, and the user, or customer, who alone controls and selects, modifies and verifies a product using that software without the assistance of either

⁴⁶ Farros ‘810, column 10, lines 51, 52.

⁴⁷ Farros ‘810, column 10, lines 54, 55.

⁴⁸ Farros ‘810, column 10, line 55.

⁴⁹ Farros ‘810, column 9, lines 23, 24.

⁵⁰ Farros ‘810, column 9, line 25.

⁵¹ Farros ‘810, steps 1007-1011, column 10, line 56.

⁵² Farros ‘810, column 10, lines 60-67.

⁵³ Farros ‘810, Figure 10 and column 10, line 60.

Appellant's "printing agency" or "editor" as set forth in rejected claim 64, is telling evidence that, on the instant record demonstrates, the impropriety of the rejection of claim 20; accordingly, allowance of claim 64 is indicated. Similarly, the common inability of both Chabrow and Farros '810, as well as the Examiner, to either appreciate a need for Appellant's "user computer", "printing agency" and "editor" as set forth in claim 64, or the singular inability of both Chabrow, Farros '810 and the Examiner to appreciate the beneficial contribution enjoyed by a user at Appellant's "user computer" with Appellant's division of labor between Appellant's "user computer", "printing agency" and "editor", and Appellant's combination with an allocation of labor between the user and a printing agency is further and additional convincing evidence on the record of the non-obviousness of claim 64. Moreover, the Examiner's inability to understand that a claim which distinctly defines separate constituent elements, is telling of the impropriety of the rejection. The Examiner can not read distinct components as comprising one in the same element. In view of this impropriety, the foregoing omissions in the Examiner's proposed combination, the advantages intrinsic in any allocation of labor between different constituent components of a claim, as well as the absence of a *prima facie* showing of obviousness, withdrawal of this rejection is required.

C. The Examiner's Propose Combination Impermissibly Prevents the Primary Reference From Operating in Its Intended Mode of Operation.

Claim 64 defines, *inter alia*, "said printing agency comprising an editor editing a manuscript composed" The primary reference however, is a singular effort for "reducing prepress cost". As explained by the primary reference, the operation is disclosed as being

inoperable,

“If most orders don’t go through *untouched* ...”

Appellant’s editing of a manuscript document is only one of a plethora of pre-press actions which may be undertaken to “touch” an order. In other words, any modification of the primary reference to incorporate “editing” is contrary to and impermissibly destroys the intended mode of operation of the primary reference. This alone constitutes convincing evidence of the non-obviousness of claim 64. Withdrawal of this rejection is therefore required.

Rejection of Claims 65 and 68 Under 35 U.S.C. §103(a)

Claims 65 and 68 are rejected under 35 U.S.C. §103(a) for alleged unpatentability over the Examiner’s proposed combination of the Internet article entitled *E-Business 100 iPrint: Self-Service Printing* by Eric Chabrow, published on the 13th of December 1999 in *Information Week OnLine*, modified in view of the PR Newswire press release, and Farros ‘810. Appellant respectfully traverses this rejection for the following reasons.

A. The Examiner’s Proposed Combination Fails To Make a *Prima Facie* Showing of Obviousness of Claims 65 and 68 Under 35 U.S.C. §103(a).

In support of this rejection the Examiner asserts that:

“a second memory for storing said finalized document after editing would provide a means for transmitting the finalized document to the printing agency ...”⁵⁴

Wholly absent from the Examiner’s proposed combination, is either teaching or suggestion of

⁵⁴ Examiner’s Comments, p. 33.

Appellant's second memory, as well as any suggestion of advantageousness of incorporating Appellant's "second memory" into the system defined by parent claim 64. Consequently, this rejection is incomplete and can not be maintained.

Rejection of Claims 67 and 74 Under 35 U.S.C. §103(a)

Claims 67 and 74 are rejected under 35 U.S.C. §103(a) for alleged unpatentability over the Examiner's proposed combination of the Internet article entitled *E-Business 100 iPrint: Self-Service Printing* by Eric Chabrow, published on the 13th of December 1999 in *Information Week OnLine*, modified in view of the *PR Newswire* press release entitled *New Internet Standard Approved To Streamline Process For Editing Documents On Web* published on the 9th of December 1998, and what the Examiner asserts is "Official Notice." These rejections are unsustainable on the record before the Board.

Claim 67 defines, *inter alia*, a printing agency constructed with:

“ plurality of output devices [that] comprise: toner type digital printers; CD-ROM printing devices; ink-jet type printers; and magnetic optical disk read/write devices.”

None of these features are found in the Examiner's proposed combination, whether taken singularly⁵⁵ or in the combination proposed by the Examiner, and substitution of generic printers 212, 312 of Ferros, *et al*, U.S. Patent No. 5.930.810 does nothing to remedy these deficiencies.

⁵⁵ Chadbrow and *PR Newswire* are both non-enabling of claim 67 under the first paragraph of 35 U.S.C. §121, and are not available as prior art under 35 U.S.C. §102(b) or (e). The "printers" mentioned in Chadbrow are tradesmen, rather than equipment. Moreover, no circuit or any other structural assembly is taught by either the primary or secondary reference.

Consequently, the rejection may not be sustained on the record before the Board.

It is noteworthy that in support of this rejection, Paper No. 29 states that,

“Farros⁵⁶ suggest [*sic*, -s] combining itss system with an output device comprising a toner type digital printer, a CD-ROM printing device, an ink jet printer or a magnetic optical disk read/write device”⁵⁷

A through reading of Farros ‘810 fails to reveal any of those terms; in fact, Farros ‘810 uses neither the term “toner”, “digital”, “ink-jet” nor “optical.” In essence, this rejection is based upon misrepresentation and fantasy.

Claim 74 defines, among other features, the “editor being a different entity than said customer.” The primary reference, Chadbrow expressly teaches that:

“[r]educing prepress costs lets iPrint price products at 25% to 50% below retail. “If most orders didn’t go through untouched, it wouldn’t be possible to scale as fast as we are and deliver the prices we offer.”⁵⁸

Modifying Chadbrow to incorporate the “*PR Newswire* ... system for collaboratively editing documents over the Internet”⁵⁹ impermissibly prevents Chadbrow from operating in its intended mode by “[r]educing prepress costs” by “automat[-ing] the prepress process” through the expediency of having the orders of customers “go through untouched.” Consequently, the

⁵⁶ Ferros, *et al*, U.S. Patent No. 5,930,810, entitled *Printing System With Pre-defined User Modifiable Forms And Local And Remote Printing*, issued on the 27th of July 1999.

⁵⁷ Paper No. 29, page 34.

⁵⁸ Internet article entitled *E-Business 100 iPrint: Self-Service Printing* by Eric Chabrow, published on the 13th of December 1999 in *Information Week OnLine*.

⁵⁹ Paper No. 29, page 37.

Examiner's proposed combination is untenable and this rejection may not be sustained. Moreover, this deficiency in the Examiner's proposed combination is irrefutable evidence of the non-obviousness of Appellant's process.

Furthermore, the proposed combination relied upon to reject claims 67 and 74 fails to remedy the deficiencies noted in parent claims 64 and 72. Consequently, these rejections may not be sustained on the record before the Board.

Rejection of Claims 75-81 Under 35 U.S.C. §103(a)

Claims 75 through 81 were finally rejected under 35 U.S.C. §103(a) as rendered obvious, and unpatentable, over the Examiner's proposed combination of the Internet article entitled *E-Business 100 iPrint: Self-Service Printing* by Eric Chabrow, published on the 13th of December 1999 in *Information Week OnLine*, modified in view of the *PR Newswire* press release entitled *New Internet Standard Approved To Streamline Process For Editing Documents On Web* published on the 9th of December 1998, Goldberg '146 and what the Examiner asserts is "Official Notice." This rejection neglects to comply with the mandate of 35 U.S.C. §103(a) that obviousness *vel non* be determined on a basis of *subject matter as a whole*, this rejection fails to present a *prima facie* showing of obviousness, this rejection constitutes an impermissible hindsight reconstruction of the art, and this rejection is incomplete and is therefore unsustainable on the record before the Board, for the following reasons.

A. This Rejection of Claims 75 Through 81 Fails To Consider *The Subject Matter As A Whole* As Is Mandated By 35 U.S.C. §103(a).

Claim 75 defines, *inter alia*,

accessing a home page of a print service through the Internet;

sending a cost request from a user through the Internet to the print service ...;

when the cost request is received by the print service ...;

generating a cost estimate in dependence upon the stored cost request ...;

when the user receives and approves the cost estimate, sending the identification data and second data about the print job from the user through the Internet to the print service, the second data including print data composed by the user independently of the print service to be recorded on recordable media”⁶⁰

Wholly absent from the Examiner’s proposed combination is either teaching or suggestion of claims 75’s sequence of,

“*when* the user receives and approves the cost estimate, sending the identification data and ... print data *composed* by the user *independently of the print service* to be recorded on recordable media”⁶¹

in combination with,

“when the stored print data is not in a final form, performing a *first editing* of the stored print data, the first editing being performed by an editor and *not by the user*”⁶²

The Examiner attempts to ignore this omission from the proposed combination by arguing that

⁶⁰ Claim 75, lines 2-13.

⁶¹ Claim 75, lines 10-13.

⁶² Claim 75, lines 16 and 17.

although,

“neither Chabrow nor Goldberg teach when the cost request is received by the print service, storing the cost request ... the Examiner takes Official Notice that storing service order price information in a file is old and well known in the art.”⁶³

The Examiner’s assertion ignores the express language of claim 75, and endeavors to argue that modification of the primary reference to incorporate a “cost request” is old and well known, without addressing the questions of (i) whether the teaching by Goldberg ‘146 of a “cost estimate” in step 76 of Figure 4, only after completion of the generation of the “customized pattern” in step 54 and only after completion of “edit design” in step 68, meets the sequence of claim 75 of having the user receive, and approve, the cost estimate before submission of the *print data* and before performing Appellant’s *first editing*;⁶⁴ and (ii) whether modification of either the Examiner’s proposed combination or even the primary reference to reverse the order of “cost estimate”, “generate customized pattern” and “edit design” is feasible? The short answer is, that unlike the sequence of Claim 75 which begins with a “cost request” and, after submission of “print data” after the customer’s approval of the “cost estimate”, in the

⁶³ Examiner’s Comments, Paper No. 29, page 36. In the penultimate paragraph of page 36, the Examiner’s Comments raise piecemeal the issue of *storing the cost request* (from claim 75, line 6) in a guise of some “point-of-novelty” criterion of obviousness, and then in the last paragraph of page 36 jumps to a consideration of *storing the print data* (from lines 14 and 15 of claim 75), while ignoring (i) how these features of *storing the cost request* and *storing the print data* are related to the remained of claim 75 and (ii) all of the features and aspects of claim 75 defined by the intervening lines of claim 75.

⁶⁴ The attention of the Board is invited that this reversal in the Examiner’s proposed combination of the sequence defined by Claim 75 is not addressed in Paper No. 29. No other component of the Examiner’s proposed combination addresses the timing of the “cost estimate” relative to a “first editing” of the *print data*.

Examiner's proposed combination (unlike claim 75) there is no basis, no data, and no design or pattern upon which to base a "cost estimate" in the Examiner's proposed combination until after the "customized pattern" has been generated and the "design" has been edited. The fact that the art failed to recognize the simplicity of operation which advantageously flows from Applicant's reversal of sequence, and that the Examiner has failed to consider the subject matter of claim 75 in its entirety is further exemplified by is highlighted by the Examiner's statement:

"it would have been obvious ... to modify Chabrow to include the teachings of Goldberg *in order to provide customers with an estimated cost for their custom print job* ... thus customers would be permitted *to compare vendors according to price*."⁶⁵

Contrary to the Examiner's assertion, the necessity of creating and then editing that *custom print job* in the Examiner's proposed combination before the Examiner's proposed combination is able to provide the customer with a cost estimate intrinsically slows, and thereby impedes, the ability of the customer to comparison shop; it is the sequence of claim 75, rather than the Examiner's incomplete proposed combination,⁶⁶ which advantageously expedites the ability of a multiplicity of customers to quickly and rapidly *compare vendors according to price*. Where Internet connectivity and bandwidth are issues of e-commerce, the Examiner's proposed combination undesirably ties up both connectivity and hogs the bandwidth required to generate

⁶⁵ Examiner's Comments, Paper No. 29, page 36.

⁶⁶ Where the rationale given in support of the rejection fails to consider the sequence defined by claim 29, the final rejection has failed to consider the claim in its entirety, and the rejection may not be lawfully sustained under 35 U.S.C. §103(a). Moreover, the failure of Paper No. 29 to consider the sequence defined by claim 75 is the hallmark of incompleteness which 37 CFR §1.104(a), (b) and (c) caution against.

a pattern, and then edit a design before the vendor has sufficient information upon which to base an estimated cost; both detriments attendant to the Examiner's proposed combination are avoided by the process of claim 75. In view of these distinctions and the noted advantages flowing therefrom, this rejection may not be maintained on the record before the Board.

B. The Examiner's Proposed Combination Fails To Present A *Prima Facie* Showing Of Obviousness 35 U.S.C. §103(a).

In Paper No. 18, the Examiner recognizes that Chabrow does not teach "sending a cost request from a user through the Internet to the print service", and admits that Goldberg '146 fails to "teach when the cost request is received by the print service, storing the cost request." The Examiner improperly relies upon "Official Notice" to assert that Appellant's step of "*storing service order price information* in a file"⁶⁷ is old and well known in the art" without citation or other authority.⁶⁸ As was earlier explained to the Examiner in Appellant's earlier filed response as well as in this paper, the availability of cost estimates is crucial to the practicality and operability of a consumer oriented e-commerce processes. The failure of the

⁶⁷ This process step is not found in Claim 75, which instead defines "storing the cost *request*." The fact that the Examiner's proposed combination depends upon Official Notice of this limitation, which is not a feature of Claim 75, is further evidence of the absence of a *prima facie* showing of obviousness.

⁶⁸ It is curious that the language considered by the Examiner in making the final rejection of claim 75, namely, "*storing service order price information* in a file" is not found in Claim 75. This is further evidence of the failure of Paper No. 29 to consider claim 75 in its entirety, as is required under 35 U.S.C. §103(b). In effect, the Examiner has replaced Appellant's claim with language of unknown origin, and then considered, and finally rejected the unknown language. This is the antithesis of a full and fair consideration of *the subject matter as a whole* which is expressly mandated by 35 U.S.C. §103(a).

Examiner to read that actual, as opposed to fictitious, language of the pending claims negates this reliance upon “Official Notice”. Accordingly, there is no *prima facie* showing of obviousness of claim 75, as defined by its actual language; therefore, this rejection may not be sustained.

C. The Examiner’s Proposed Combination Is A Hindsight Reconstruction Of The Art In The Light Provided By Applicant Alone.

Claim 75 reads,

“when the user receives and approves the cost estimate, sending the identification data and second data about the print job from the user through the Internet to the print service, the second data including print data composed by the user independently of the print service to be recorded on recordable media;

when the second data and the identification data are received by the print service, storing the print data;

when the stored print data is not in a final form, performing a first editing of the stored print data, the first editing being performed by an editor and not by the user ...”⁶⁹

Paper No. 29 admits that the,

“combination of Chabrow and Goldberg do not expressly teach when the stored print data is not in a final form, *performing a first editing of the stored print data*, the first editing being performed by an editor *and not by the user*.”⁷⁰

Paper No. 29 then asserts that:

“PR Newswire teaches a system for collaboratively editing documents over the Internet ... [and] it would have been obvious

⁶⁹ Claim 75, lines 10-17.

⁷⁰ Paper No. 29, page 37, emphasis added.

... to modify Chabrow and Goldberg to include the teachings of PR Newswire because including an editor at said printing agency having access to software and hardware to monitor, evaluate and modify said document created by said customer at said user terminal and to store said modified document in a second memory at said printing agency would enable the customer to improve the quality of their documents.”⁷¹

It is unclear that the Examiner appreciates the import of the proposed combination including the suggestions of the *PR Newswire* article, which describes the *Distributed Authoring and Versioning Standard* (i.e., the WebDAV standard).

As explained by the *RP Newswire* article, the WebDAV standard allows collaborative editing of encoded web documents, i.e., metadata, by providing “overwrite prevention” and “name-space management” which avoid what was then referred to as the “lost update problem.” Under the WebDAV standard however, “prevents more than one person from working on a document at the same time.”⁷²

Ignoring *arguendo* that the Examiner’s proposed combination contemplates editing of “metadata”, rather than Appellant’s “*print data*” suitable for “recording ... in the final form on the *recordable media*”,⁷³

D. The Examiner’s Consideration of Claim 75 Is Incomplete, Fails To Consider The Differences Between The Subject Matter Sought To Be Patented And The Prior Art, And Fails To Make a *Prima Facie* Showing of Obviousness Under 35 U.S.C. §103(a).

⁷¹ Paper No. 29, page 37.

⁷² *PR Newswire*, page 2.

⁷³ Claim 75, lines 20 and 21.

Consideration of issues of obviousness under 35 U.S.C. §103(a) required an identification of “the differences between the subject matter sought to be patented and the prior art.” Claim 75 defines, *inter alia*,

6 “when the cost request is received by the print service,
7 storing the cost request;
8 generating a cost estimate in dependence upon the stored
9 cost request, sending the cost estimate through the Internet to the
10 user, the cost estimate including identification data and including
11 the estimate of the cost of the print job;
12 when the user receives and approves the cost estimate,
13 sending the identification data and second data about the print job
14 from the user through the Internet to the print service, the second
15 data including print data composed by the user independently of
16 the print service to be recorded on recordable media;
17 when the second data and the identification data are
18 received by the print service, storing the print data”

In the penultimate paragraph of page 36, the Examiner’s Comments raise piecemeal the issue of *storing the cost request* (from claim 75, line 6) in a guise of some “point-of-novelty” criterion of obviousness, and then in the last paragraph of page 36 jumps to a consideration of *storing the print data* (from lines 14 and 15 of claim 75), while ignoring (i) how these features of *storing the cost request* and *storing the print data* are related to the remained of claim 75 and (ii) all of the features and aspects of claim 75 defined by the intervening lines of claim 75.

Absent from the Examiner’s consideration are such features as Applicant’s:

“when the user receives and approves the cost estimate, sending ... second data about the print job from the user ..., the second data including *print data composed by the user independently of the print service* to be recorded on recordable media .. .”⁷⁴

⁷⁴ Claim 75, lines 10 - 12.

Consequently, Paper No. 29 fails to consider Appellant's combination of:

“when the user receives and approves the cost estimate, sending ... second data about the print job from the user ..., the second data including *print data composed by the user independently of the print service* to be recorded on recordable media ...”⁷⁵

and

“when the stored print data is not in a final form, *performing a first editing of the stored print data*, the first editing being performed *by an editor* and not by the user ...”⁷⁶

Instead, the Paper No. 29 completely ignores the former feature, completely ignores the excerpted combination, and paraphrases the latter feature as “a system for collaboratively editing documents over the Internet.”⁷⁷ In short, the Paper No. 29 has selectively paraphrased isolated features of claim 75, in a piecemeal fashion, while making a wholesale erasure from the consideration, entire constituent components defining other features of claim 75. This style of examination fails not only to comply with the requirements of 35 U.S.C. §103(a) to identify the “differences” and to consider “the subject matter as a whole,” but the direction of 37 CFR §1.104(b) and (c)(2) for completeness. By selectively ignoring entire constituent components of claim 29, and by substituting paraphrased language for the express text of other features of claim 75, Paper No. 29 presents the Board with an incomplete record devoid of a basis for denying allowance of claim 75.

⁷⁵ Claim 75, lines 10 - 12.

⁷⁶ Claim 75, lines 16 and 17.

⁷⁷ Paper No. 29, page 37, “[h]owever, *PR Newswire* teaches a system for collaboratively editing documents over the Internet.”

E. The Record Of This Application Is Devoid Of The Requisite Evidence Of Motivation Necessary Under 35 U.S.C. §103(a) To Construct The Examiner's Proposed Combination.

Paper No. 29 admits that the,

“combination of Chabrow and Goldberg do not expressly teach when the stored print data is not in a final form, *performing a first editing of the stored print data*, the first editing being performed by an editor *and not by the user*.”⁷⁸

Paper No. 29 then asserts that:

“PR Newswire teaches a system for collaboratively editing documents over the Internet ... [and] it would have been obvious ... to modify Chabrow and Goldberg to include the teachings of PR Newswire because including an editor at said printing agency having access to software and hardware to monitor, evaluate and modify said document created by said customer at said user terminal and to store said modified document in a second memory at said printing agency would enable the customer to improve the quality of their documents.”⁷⁹

Then, in one of the more fanciful leaps found in Paper No. 29 to circumvent 35 U.S.C.

§103(a), Paper No. 29 states that,

“it would have been obvious ... to modify Chabrow and Goldberg to include the teachings of PR Newswire because including an editor at said printing agency ... would enable the customer [*sic*, customers] to improve the quality of their documents.”⁸⁰

Not only does this piecemeal approach to examination fail to comply with 35 U.S.C. §103(a), but it ignores the absence of the motivation necessary to modify the primary reference.

⁷⁸ Paper No. 29, page 37, emphasis added.

⁷⁹ Paper No. 29, page 37.

⁸⁰ Paper No. 29, page 37.

What is missing from the Examiner's construct of this proposed combination, is the motivation necessary to modify the primary reference in conformance with the Examiner's assertion that "*PR Newswire* teaches a system for collaboratively editing documents over the Internet."⁸¹ Chadbrow expressly teaches that:

"[r]educing prepress costs lets iPrint price products at 25% to 50% below retail. "If most orders didn't go through untouched, it wouldn't be possible to scale as fast as we are and deliver the prices we offer."⁸²

Modifying Chadbrow to incorporate the "*PR Newswire* ... system for collaboratively editing documents over the Internet"⁸³ impermissibly prevents Chadbrow from operating in its intended mode by "[r]educing prepress costs" by "automat[-ing] the prepress process" through the expediency of having the orders of customers "go through untouched." Consequently, the Examiner's proposed combination is untenable and this rejection may not be sustained. Moreover, this deficiency in the Examiner's proposed combination is irrefutable evidence of the non-obviousness of Appellant's process.

Rejection of Claims 38-44 Under 35 U.S.C. §103(a)

Claims 38 through 44 were newly rejected in the final Office action under 35 U.S.C. §103(a) as being unpatentable over the Examiner's proposed combination of Goldberg *et al.*,

⁸¹ Paper No. 29, page 37.

⁸² Internet article entitled *E-Business 100 iPrint: Self-Service Printing* by Eric Chabrow, published on the 13th of December 1999 in *Information Week OnLine*.

⁸³ Paper No. 29, page 37.

U.S. Patent No. 6,196,146, modified according to the PR Newswire article, the Internet article entitled *E-Business 100 iPrint: Self-Service Printing* by Eric Chabrow, published on the 13th of December 1999 in *Information Week OnLine*, and what the Examiner asserts is “Official Notice” of five (5) distinct features of Appellant’s claims. This rejection is unsustainable for the following reasons.

A. The Examiner Failed To Consider The Subject Matter Of Rejected Claims 38 through 44 As A Whole.

Under U.S. practice, a patent must be issued to an Appellant unless,

“the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made”⁸⁴

The Examining Staff has sought to examine these claims piecemeal, by asserting that various, diverse references, could be argued to teach various constituent components of these claims, and where the primary and secondary references were admitted by the Examining Staff to be lacking, the proposed combination relied upon “Official Notice” to supply the missing constituent component. Specifically, the Examiner’s proposed combination includes:

1. “Official Notice that the use of a password for accessing the customer’s estimate is old and well known in the art.”⁸⁵
2. “Official Notice of the fact that storing customer order profile information on a remote database is old and well known in the art.”

⁸⁴ 35 U.S.C. §103(a).

⁸⁵ Examiner’s Comments, page 15.

3. “Official Notice that providing a customer contact information, including an e-mail address, is old and well known in the art.”
4. “Official Notice of the fact that selecting a service provider based on their geographical location is old and well known in the art.”
5. “Official Notice that these are common parameters (namely, a number of pages of the print job, a number of copies of the print job, a type of binding of the print job) that are indicated by a customer when ordering a print job”.

The impropriety in this style of examination lies in, among other deficiencies, the fact that almost all inventions are combination of old elements. Assuming *arguendo* that each of these individual items of “Official Notice” are in fact old and well known, the incorporation of these several items of “Official Notice” into the proposed combination to modify the primary reference begs the central issue of 35 U.S.C. §103(a) of whether, when the subject matter of each claim is **considered as a whole**, “the differences between the subject matter ... [of each claim] and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made ...”? ⁸⁶ The ethereal nature of the “Official Notice” not only lacks relevance to the **subject matter considered as a whole**, but there is no evidence of record here to even indicate that the use of each item of “Official Notice” could feasibly be incorporated into the primary reference without impermissibly preventing the primary reference from being operated in its intended mode of operation. In short, this rejection fails to comply with the dictate of 35 U.S.C. §103(a) to consider the subject matter of each claim **as a whole**,

⁸⁶ 35 U.S.C. §103(a).

and instead, has improperly substituted a consideration of individual constituent features of the rejected claims in isolation from the remainder of those claims. Moreover, not only has this rejection failed to consider the subject matter of these claims “as a whole”, the diverse items of “Official Notice” that have been incorporated into the Examiner’s proposed combination are ethereal and unconnected to the specific teachings of the primary reference; apparently those diverse items of “Official Notice” have been drawn the vast and amorphous body of all prior art, without considerations of relevance or materiality.⁸⁷ Consequently, there is no basis in the evidence of record to justify the rejection of claims 38 through 44 under 35 U.S.C. §103(a). Withdrawal of this rejection is required.

B. There Is No Evidence Of Record Of Motivation For Modifying The Primary Reference As Required By The Examiner’s Proposed Combination.

As is noted in the foregoing paragraphs, the Examiner’s proposed combination relies upon five distinct instances of “Official Notice”. The record of this application is devoid of evidence teaching any motivation for modifying the primary reference to conform to this “Official Notice”; instead the Examining Staff has substituted various platitudes, none of which are supported by evidence of record, to justify the modifications:

1. “Goldberg does not expressly teach providing a cost estimate for a printing job. However, the Examiner notes it would have been obvious to modify Goldberg to provide cost estimate for printing

⁸⁷ When patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied upon as evidence of obviousness. *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 13521-52, 60 USPQ2d 101, 1008 (Fed. Cir. 2001).

jobs in order to expand the scope of application of Goldberg.”⁸⁸

2. “Goldberg does not expressly teach providing a customized good comprising a printed product. However, because Goldberg provides cost estimates for customized products, it would have been obvious to apply Goldberg to the providing of cost estimates for printed products.”⁸⁹
3. “At the time of Appellants' invention, it would have been obvious to one of ordinary skill in the art, to modify Goldberg to include the teachings of PR Newswire because including an editor at said printing agency having access to software and hardware to monitor, evaluate and modify said document created by said customer at said user' terminal and to store said modified document in a second memory at said printing agency would enable the customer to improve the quality of their documents.”
4. “At the time of Appellant's invention, it would have been obvious to one of ordinary skill in the art, to modify Goldberg and PR Newswire to include a second memory unit storing the print data when the print data is in the final form, said second memory unit being in communication with said editing unit; and an output device receiving the print data in the final form from said second memory unit, and recording the print data in the final form on the recordable media in order to store customer's custom order parameters, and then reduce the order to its tangible requested form.”
5. “Therefore, at the time of Appellant's invention, it would have been obvious to modify Goldberg, PR Newswire and Chabrow to include the use of a password in order to provide security to the customer's order information.”

⁸⁸ Examiner's Comments, p. 13.

⁸⁹ Examiner's Comments, p. 15.

6. “Therefore, at the time of Appellant's invention, it would have been obvious, to modify Goldberg, PR Newswire and Chabrow to include a first memory unit storing the cost request and the identification data received from said server, said first memory unit being in communication with said server. This combination would enable customers to access their information at a later date.”
7. “Therefore, at the time of Appellant's invention, it would have been obvious to one of ordinary skill in the art, to modify Goldberg, Chabrow and PR Newswire to include the identification data corresponding to an e-mail address of the user in order to provide a convenient means for contacting customers.”
8. “At the time of Appellant's invention, it would have been obvious to one of ordinary skill in the art, to modify Goldberg, PR Newswire and Official Notice to include the teachings of Chabrow in order to outsource printing jobs when special printing needs are required.”⁹⁰
9. “Therefore, at the time of Appellant's invention, it would have been obvious to one of ordinary skill in the art, to modify Goldberg, Chabrow and PR Newswire to include selecting the output device \geographically nearest to the user. This would provide the user with the most convenient pick-up location.”⁹¹
10. “At the time of Appellants' invention, it would have been obvious to one of ordinary skill in the art, to modify Goldberg, Chabrow and Official Notice to include the teachings of PR Newswire because this would enable the customer to improve the quality of his documents.”⁹²

⁹⁰ Examiner's Comments, p. 16.

⁹¹ Examiner's Comments, pp. 16-17

⁹² Examiner's Comments, p. 17

11. “At the time of Appellants' invention, it would have been obvious to one of ordinary skill in the art, to modify Goldberg, Chabrow and Official Notice to include the teachings of PR Newswire because including an editor at said printing agency having access to software and hardware to monitor, evaluate and modify said document created by said customer at said user terminal and to store said modified document in a second memory at said printing agency would enable the customer to improve the quality of their documents.”⁹³
12. “Therefore, at the time of Appellant's invention, it would have been obvious to one of ordinary skill in the art, to modify Goldberg, Chabrow and PR Newswire to include a number of pages of the print job, a number of copies of the print job, a type of binding of the print job in order to enable customers to provide complete order information.”⁹⁴

It is fundamental under U.S. practice that rejections under 35 U.S.C. §103(a) “must be based on evidence comprehended by the language of that section.”⁹⁵ When patentability turns on the question of obviousness, “the central question is whether there is reason to combine [the] references”;⁹⁶ this is a question of fact drawing on the *Graham* factors.⁹⁷ Where for example, does the record show that it would be desirable “to expand the scope of application of

⁹³ Examiner's Comments, p. 17.

⁹⁴ Examiner's Comments, p. 18.

⁹⁵ *In re Grasselli*, 713 F.2d 731, 739, 218 USPQ 769, 755 (Fed. Cir. 1983).

⁹⁶ *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 13521-52, 60 USPQ2d 101, 1008 (Fed. Cir. 2001).

⁹⁷ *Graham v. John Deere Co.*, 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966).

Goldberg”, were to “enable the customer to improve the quality of their documents”, or to include a “second memory unit storing the print data when the print data is in final form”, or to “include the use of a password in order to provide security to the customers order information”, or to “enable customers to access their information at a later date”, or “to provide a convenient means for contacting customers”, or “to outsource printing jobs when special needs are required”, or to “improve the quality of [the] customers documents”, or to “enable the customer to improve the quality of the documents”, or to “enable customers to provide complete order information”? Each of these statements have been used by the Examining staff to justify modification of the primary reference. Such desires, motivation and suggestions for modification of the primary reference are not taught in the secondary references however. These are simply “hindsight” assertions made in light of the express language of Appellant’s claims, and are unsupported by the art. This factual inquiry of whether to combine reference must be thorough and searching, and this inquiry must be based on objective evidence of record; it is reinforced in myriad decisions of the Federal Circuit, and may not be summarily dispensed with.⁹⁸ Accordingly, absent the requisite “showing of a suggestion, teaching, or motivation to combine the prior references” in the record before the Examining Staff, a showing which is “an essential component of an obvious holding”,⁹⁹ there is no basis for continuing this rejection of claims 38 through 44. Its withdrawal is respectfully requested.

⁹⁸ See, for example, *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124-25, 56 USPQ2d 1456, 1459 (Fed. Cir. 2000).

⁹⁹ *C.R. Bard, Inc. v. M3 Systems, Inc.*, 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir.), and *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1998).

C. The Examiner's Proposed Combination Fails To Make A *Prima Facie* Showing Of Obviousness Under 35 U.S.C. §103(a).

The Examiner admits that Goldberg '146 includes several remarkable deficiencies, and does not meet the definition provided by independent claim 38.

The Examiner's motivation for this proposed combination is flawed and factually incorrect. The Examiner relies upon the PR Newswire article to modify Goldberg '146 to include "an editor at said printing agency having access to software and hardware to monitor, evaluate and modify said document created by said customer at said user terminal ..." and asserts that the motivation for this modification of Goldberg '146 "would enable the customer to *improve the quality* of their documents." Paper No. 11, pg. 28. In fact, the Examiner's proposed combination would impermissibly destroy the intended mode of operation of Goldberg '146 which teaches editing, in step 68, as being done exclusively and solely by the user. See col. 4, line 6+. Moreover, the Examiner has misrepresented the teachings of the secondary reference; the PR Newswire discloses "web editing software", which "allows people to easily and collaboratively edit their web documents" in order to avoid the problem known as the "lost update problem." Goldberg '146 however, contemplates no editing by anyone other than the user; the Examiner's proposed combination encounters no "lost update problem" because the primary reference is dealing in tangible, un-updated products. Consequently, this proposed modification of the primary reference is unsupported by evidence in the record before the Board of motivation to incorporate "web site editing" into the primary reference. In step 54, the embroidery service provides a facsimile in lieu of a prototype, but defers any editing or

modification of the facsimile to the user in step 68. The Examiner's proposed modification of Goldberg '146 would impermissibly rob the user of this exclusivity, and ostensibly open the editing of the garment being manufactured for the user by the Examiner's proposed combination to the public. How this modification "would enable the customer to improve the quality of their documents" is unexplained in the Examiner's action, because it is a garment, and not a document, that is created by Goldberg '146. Furthermore, this rejection is deficient because the Examiner neglects to identify precisely where this third party editing of the garment would occur in Goldberg '146; subsequent to the simulation modeling in step 54 or subsequent to the user's editing in step 68 would interfere with the user's creativity. Any subsequent third party editing would destroy that final creation. In short, this rejection is incomplete under the criteria of 37 CFR §1.104(b) and (c). Written clarification and allowance of an opportunity for Appellant to respond to the completed rejection is respectfully requested. Alternatively, withdrawal of this rejection and allowance of the rejected claims is solicited.

The Examiner has taken Official Notice of the use of a password for accessing a customer's estimate and Official Notice of storing customer order profile information on a remote database. In accordance with 37 CFR §1.104 (a), (b) and (c), the Examiner's affidavit detailing the data relied upon by the Examiner for this Official Notice is respectfully requested.

Rejection Of Claims 39-42 And 44 Under 35 U.S.C. §103(a)

Claims 39 through 42 and 44 were rejected under 35 U.S.C. §103(a) as rendered obvious, and unpatentable, over the Examiner's proposed combination of Goldberg '146, Chabrow, the

PR Newswire article and the Examiner's Official Notice. Appellant respectfully traverses these rejections for the following reasons.

First, these claims all ultimately depend upon independent claim 38. The Examiner's proposed combination does not remedy the deficiencies noted in the foregoing paragraphs of this paper, in the rejection of claim 38. Accordingly, this rejection is incomplete and improper. Its withdrawal is required.

Second, claim 39 defines, *inter alia*, correction of spelling. Goldberg makes no pretense of interfering with a customer's spelling; modification of Goldberg to provide correction of spelling would impermissibly destroy the intended mode of operation of Goldberg, which encompasses production of produces displaying a user's unique selection f spelling. Accordingly, this rejection of claim 39 is improper and may not stand.

Dependent claim 40 contemplates enabling the user to select "the output device geographically nearest to the user"; this feature is neither taught nor suggested by any of the applied references. It is difficult to understand how these references could be relied upon to render this feature of claim 40 obvious, when none of these references use the terms "geographically nearest to the user"? In view of the implausibility of the Examiner's rationale, withdrawal of this rejection is required. The Examiner has relied upon Official Notice as teaching geographic location and the selection of service based upon the geographic location. The Examiner is requested in accordance with 37 CFR § 1.104 to provide his affidavit specifying the data upon which the Examiner has relied for this Official Notice, and to accord Appellant an opportunity to contradict and challenge the Examiner's data.

Claim 41 contemplates transmission of “edited print data through the Internet to the user after said editing unit performs the editing of the print data” and “the user receiving the edited data through the Internet and revising the edited print data and sending the revised print data to the server. This combination is not suggested by any of the Examiner’s references, and may not therefore be attributed to the Examiner’s proposed combination. The fact that the PR Newswire mentions, but does not teach, a system for collaboratively editing what is known as “web documents” is irrelevant to the issue of the obviousness of claim 41. The PR Newswire Paper acknowledges that its distributed authority and versioning standard will allow “users to conveniently manage Internet files and directories, including the ability to move and copy files, similar to the way word-processing files and directories are managed on a regular computer.” Pg. 2. What is missing from this reference is teaching or suggestion of editing “word-processing files and directories” by an editing unit that is defined as “being distinguishable from the user” (pg. 38, line 16).¹⁰⁰ In fact, the web editing contemplated by the PR Paper allows collaborative editing of web documents, but neither teaches nor suggests modification of a service such as that provided by Goldberg ‘146, the primary reference, which enables the user to obtain the editor’s services. The Examiner should again consider that claim 38 separately and distinctly defines Appellant’s “editing unit” and “user”, although the user is not constituent component of claim 38. The Examiner’s pretense that the editing unit and the user are one in the same entity, is contrary to U.S. practice. Accordingly, there is no basis for making the

¹⁰⁰ “an editing unit ... being distinguishable from the user” is a feature of Appellant’s claim 38, lines 14-16, which is not present in the Examiner’s proposed combination.

Examiner's proposed combination, the combination would destroy the intended mode of operation of Goldberg, and the combination fails to make a *prima facie* showing of obviousness of claim 41.

Although Goldberg does generate a cost estimate, that cost estimate does not remedy the foregoing deficiencies noted in the Examiner's proposed combination. Accordingly, claim 42 is patentably distinguishable and allowable over the prior art.

In support of the rejection of claim 44, the Examiner argues that his Official Notice of attributes of the job such as the number of pages, the number of copies, and the type of binding, are old and well known. None of the references suggest these attributes. Moreover, the Examiner's Official Notice fails to remedy the deficiencies noted in the rejection of parent claim 38. Accordingly, claim 44 is deemed to be patentably distinguishable and allowable over the prior art.

Rejection of Claims 45, 46, 52 and 71 Under 35 U.S.C. §103(a)

Claims 45, 46, 52 and 71 are rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over the Examiner's proposed combination of Farros, U.S. Patent No. 5,930,810 in view of Goldberg '146, and the PR Newswire press release. Appellant respectfully traverses this rejection for the following reasons.

A. The Examiner's Proposed Combination Fails To Make a *Prima Facie* Showing of Obviousness of the Apparatus Defined by Claims 45, 46, 52 and 71 Under 35 U.S.C.

In support of this rejection of claims 45, 46, 52 and 71, the Examiner wrote that Farros

'810 taught an Internet printing apparatus, comprising:

“a printing agency, comprising a server disseminating a home page that, in response to an inquiry by a customer over the World Wide Web, provides instructions explaining how a customer can request a print job, and enables a customer to select and to modify attributes of said print job, said home page, said home page further comprising a form that may be accessed through a hyperlink, said form enabling a customer to request said print job of a first draft received from the customer (col. 2, lines 24-27 and 51-55; col. 4, lines 27-30; col. 7, lines 46-51 and 53-65; and col. 8, lines 15-17);

said printing agency comprising a memory storing a customer's choice of attributes for said print job and, storing a first draft of said print job and that is received from the customer via the World Wide Web (col. 8, lines 14-20);

said printing agency comprising an editor connected to said memory to edit said first draft of said print job to create a first revision of said first draft (col. 8, lines 30-36 and 42-67; Fig. 4);

said memory being connected to said editor storing said finalized version of said print job (col. 11, lines 45-52); and

an output device connected to said second memory via network printing to download said finalized version onto a recording media at a location that is geographically compatible with the customer's choice (col. 2, lines 27-32)” (quoting from pages 18 and 19 of Paper No. 18).

First, neither this excerpt nor the language used in this excerpt is found anywhere in the Examiner's proposed combination; this language is found only in Appellant's pending claims. Consequently, the Examiner's proposed combination fails to make a *prima facie* showing of obviousness.

Second, the Examiner's understanding of the Examiner's proposed combination

including Farros '810 is flawed. In the Examiner's proposed combination, Farros '810 teaches a print service that enables a customer, to:

- "chose to create a new order or to read in (and then modify) an existing order." Col. 9, lines 22, 23.
- choose from among "any number of categories of product" ... "(such as business cards or personal calling cards)." Col. 9, lines 24-26.
- choose within the specific category, "a number of different layouts [that] are usually available." Col. 9, lines 26, 27.
- make "at step 1016, a final visual verification of the print order [that] is displayed." Col. 10, lines 62-64.

As explained in Farros (*see*, by way of example, column 4, beginning with line 20), this is a template-based system enabling the use to create "a number of types of printed products regularly used." Figure 1 illustrates this "creation" of the print job in a single step 114, and subsequently in Figure 7, explains the different attributes of the print job that might be either changed or set by default for the printing job.

The Examiner ignores Appellant's definition in claim 45 of "a printing agency ... that, in response to an inquiry by a customer ... enables a customer to select and to modify attributes of said print job" in combination with Appellant's "printing agency ... storing a first draft of said print job composed by the customer independently of said printing agency as a work that is textually distinct from said attributes and that is received from the customer via the World Wide Web, in combination with "said printing agency comprising an editor connected ... to receive from the customer via the World Wide Web, a second draft prepared by the customer

in dependence upon said first revision" What the Examiner has done is to confuse the selection of the templates in the Examiner's proposed combination, with several different features of claim 45; modification of those templates may not be read as teaching both enablement of the customer "to select and modify attributes" as well as creation of "a first revision of said first draft" that has been received by the printing agency and was "composed by the customer independent of said printing agency" as well as "a second draft prepared by the customer". The Examiner has read too many features into a basic teaching of the proposed combination. Moreover, the Examiner has failed to address how selection of template attributes in the proposed combination might be simultaneously read as enabling the customer to modify attributes and to create a first revision of a first draft composed "by the customer independently of said printing agency", as well as read to teach "a work that is textually distinct from said attributes."¹⁰¹ These omissions in the proposed combination may not be ignored in determining obviousness; these distinctions advantageously endow Appellant's apparatus with ability to handle more than "a number of types of printed products regularly used" as taught by the Examiner's proposed combination. In view of the foregoing deficiencies and incompleteness in the Examiner's proposed combination, withdrawal of this rejection and allowance of claims 45, 46, 52, 54 and 71 is required.

¹⁰¹ The Examiner inaccurately asserts that the PR Newswire "teaches a system for collaboratively editing documents over the Internet." Actually, this reference enables individuals sequential editing of successive versions of a document, and contemplates neither customers, estimation of cost of production of finished products. Its incorporation into the Examiner's proposed combination is disingenuous.

Rejection of Claims 47-51 Under 35 U.S.C. §103(a)

Claims 47-51 are rejected under 35 U.S.C. §103(a) for alleged unpatentability over the Examiner's proposed combination of Farros '810 modified in view of Goldberg '146 and what the Examiner identified as "Official Notice." Appellant respectfully traverses this rejection for the following reasons.

First, in support of this rejection, the Examiner asserted without authority or citation of any art, that he took:

"Official Notice that determining whether or not to include a cover page and the type of bending to be used for a print job is old and well known in the art."

Appellant disagrees. In essence, the Examiner has improperly applied an impermissible point-of-novelty criterion to the determination of obviousness under 35 U.S.C. §103, and then begged the question of whether the Examiner's point-of-novelty, namely "determining whether or not to include ..." is obvious by taking "Official Notice that editing a customer's print job at a print agency connected to the customer via the Internet *is old and well known in the art.*" This is an impermissible application of 35 U.S.C. §103(a) which requires (1) an identification of "the differences between the subject matter sought to be patented and the prior art" and (2) a determination of whether "the subject matter *as a whole* would have been obvious at the time the invention was made." Paper No. 18 is therefore incomplete. In accordance with 37 CFR §1.104(b) and (c), the Examiner is respectfully requested to provide clarification and to explain:

- each of the "differences between the subject matter sought to be patented and the prior art", as that subject matter is defined by independent claim 47.

- which combination of specific teachings in the prior art render the “subject matter” of claim 47 when taken “as a whole” obvious?
- additionally, the Examiner’s reliance upon “Official Notice” is improper and unfairly denies the Appellant the ability to examine the body of knowledge upon which that Official Notice is based and to distinguish the pending claims over that body of knowledge because the Examiner is relying upon his personal knowledge. In accordance with 37 CFR §1.104(d)(2), the Examiner is respectfully requested to provide the Examiner’s affidavit and in that affidavit describe the data as specifically as possible, and to support that data with the Examiner’s affidavit, in order to accord the Appellant an opportunity to contradict or explain the patentability of these rejected claims over the data and reference relied upon by the Examiner in his “Official Notice.”

Appellant submits that the *combination* of having a print agency electronically connected to a customer’s computer terminal via the internet, the print agency being able to print at a remote location, and the fact that editing takes place at the Internet print agency is neither old nor well known in the art, and it is not taught nor suggested by the prior art.¹⁰²

Appellant submits that the notion that a traditional print shop may have editing services may not be relied upon in order to not infer that it is obvious under the “subject matter as a whole” criterion of 35 U.S.C. §103 to establish that the process defined by Appellant’s claim 47 is rendered obvious by the proposed modification of Farros ‘810. No matter how modified according to the Examiner’s “Official Notice” of editing, the proposed modification of Farros ‘810 is devoid of either teaching or suggestion for responding to Appellant’s print request containing attributes of a printing job by issuing “a cost estimate” and then “receiving a first

¹⁰²

These issues have not been addressed in Paper No. 18. The factual inquiry of whether to combine references must be thorough and searching under 35 U.S.C. §103(a), as has been explained in opinion such as *McGinely v. Franklin Sports, Inc.*, 262F.3d 1339, 60 USPQ2d 1001 (Fed. Cir. 2001).

draft of a customer's printing job". Instead, the proposed modification of Farros '810 including Goldberg '146 simply obtains and allows the customer to change or modify the attributes of the printing job, and then allows the user to verify those attributes; only then does the proposed modification of Farros '810 including Goldberg '146 discuss pricing and nowhere precedes the reception of the printing job with a cost estimate. Consequently, the proposed modification of Farros '810 is difficult and cumbersome for a user and requires that the printing job be completed before the user is given any inkling or notion of the cost. This requires to user to cancel the printing job and to re-start the printing job by selecting different menus, templates and modifications before the user is able to obtain the cost of the printing job. In contradistinction, claim 47 defines a process in which the attributes are first obtained, a cost estimate is readily issued and then the printing job itself is conveyed by the user to the agency and, unlike the proposed modification of Farros '810, the user receives the benefit of editing by the agency, a feature wholly lacking and neither appreciated nor suggested by the proposed modification of Farros '810. In view of these deficiencies in the Examiner's proposed modification of Farros '810, and the advantageous results flowing therefrom, claim 47 is patentably distinguishable and allowable over the prior art. Such action is respectfully requested.

Second, regarding claim 55, Appellant submits that Farros '810 does not disclose a printing agency and Farros '810 does not disclose any Internet connection to a print agency via the Internet. In Farros '810, all of the software needed to produce the document to be printed, the print order and the payment and quote are all done at either the customer's personal

computer or a kiosk. The only exception to this is FIG. 4 of Farros '810, where the customer connects to software for producing the document and placing the print order via the internet *in an office environment*. This requires that customer to incur the expense of obtaining and maintaining that software before undertaking a printing task, an expense that a customer or user is able to avoid in the practice of Appellant's claim 55. Appellant submits that reference numeral 401 in Farros '810 is not a print agency but is merely a storage that can be accessed by others in the same office. Reference numeral 401 in FIG. 4 of Farros '810 is not an internet site with a web page or a home page as claimed by Appellant. The purpose of reference numeral 401 in FIG. 4 of Farros '810 is to avoid requiring each and every user in an office environment from having to store the software to produce the document and the storage of the document itself to be printed at a user's personal computer. FIG. 4 of Farros '810 enables people in an office environment to access the software, not enabling the entire world wide web to access the software. Thus, it is submitted that FIG. 4 of Farros '810 does not have a home page and does not provide access to all internet users in the world wide web access to the software needed to create a document, to get a price quote or to submit a job order to a remote printer. In view of these distinctions and the noted benefits flowing therefrom, claim 55 is patentably distinguishable and allowable over the Examiner's proposed combination.

Rejection of Claim 53 Under 35 U.S.C. §103(a)

Claim 53 are rejected under 35 U.S.C. §103(a) for alleged unpatentability over the Examiner's proposed combination of Farros '810 modified in view of Goldberg '146, the PR

Newsire press release and Chabrow. Appellant respectfully traverses this rejection for the following reasons.

A. The Examiner's Proposed Combination Fails to Make a *Prima Facie* Showing of Obviousness Under 35 U.S.C. §103(a)

In support of this rejection, the Examiner inaccurately asserts that:

"Farros suggest[s] incorporating an editing step comprising correcting misspellings, correcting typographical errors, and correcting unreadable characters due to different software computer programs and different font environment in that Farros disclose[s] having a user perform a final verification of a print job order (col. 3, lines 10- 14)" (emphasis supplied).

This is a fanciful and improper attribution of the language of Appellant's claim to the Examiner's proposed combination, in a misguided effort to reconstruct the art in the light provided by Appellant alone. The portion of the primary reference incorporated into the Examiner's proposed combination cited by the Examiner in column 3, teaches, in its entirety,

"The printing system allows for final verification of the design as well as providing billing options and transmitting the billing information, shipping information as well as the design to the remote printing facility. The printing system may be easily updated with new forms to expand the number of designs which may be created."¹⁰³

Nowhere does the Examiner's proposed combination teach "correcting misspellings, correcting typographical errors" as asserted by Paper No. 18. Moreover, such correction would impermissibly interfere with the intended and disclosed mode of operation of the primary reference, which allows:

¹⁰³ Farros '810, column 3, lines 10-16.

“different aspects of the product which may each be changed by the user to personalize the printed product”¹⁰⁴

The inaccurately suggested “editing step comprising correcting the step comprising correcting misspellings, correcting typographical errors” would impermissibly prevent and interfere with customers’ attempts at customerization involving misspelling, different typographic formats and other items regarded by editors as “errors” and “misspellings”. In short, not only is there an absence of this feature in the Examiner’s proposed combination, its creation would impermissibly destroy the intended mode of operation of the primary reference. This, by itself, is convincing indicia of the non-obviousness of claim 53.

Rejection of Claims 55-57, 60-62, 69 and 70 Under 35 U.S.C. §103(a)

Claims 55-57, 60-62, 69 and 70 are rejected under 35 U.S.C. §103(a) for alleged unpatentability over the Examiner’s proposed combination of Farros ‘810 modified in view of Official Notice and the PR Newswire press release. Appellant respectfully traverses this rejection for the following reasons.

A. The Examiner’s Proposed Combination Fails to Make a *Prima Facie* Showing of Obviousness of the Apparatus Defined by Claims 55-57, 60-62, 69 and 70 Under 35 U.S.C. §103(a).

First, in support of this rejection, the Examiner asserted without authority or citation of any art, that he took:

“Official Notice that receiving an online estimate for a service is

¹⁰⁴ Column 2, lines 54-55.

old and well known in the art.”

Appellant disagrees. The type of that “service” and the technique for integrating the rendition of the “online estimate” are critical features which determine the viability of a process; consequently, such distinctions as defined by the rejected claims may not be ignored under 35 U.S.C. §103(a). In essence, the Examiner has improperly applied an impermissible point-of-novelty criterion to the determination of obviousness under 35 U.S.C. §103, and then begged the question of whether the Examiner’s point-of-novelty, namely “editing a customer’s print job at a print agency” is obvious by taking “Official Notice that editing a customer’s print job at a print agency connected to the customer via the Internet *is old and well known in the art.*” This is an impermissible application of 35 U.S.C. §103(a) which requires (1) an identification of “the differences between the subject matter sought to be patented and the prior art” and (2) a determination of whether “the subject matter *as a whole* would have been obvious at the time the invention was made.” Paper No. 11 is therefore incomplete. In accordance with 37 CFR §1.104(b) and (c), the Examiner is respectfully requested to provide clarification and to explain:

- each of the “differences between the subject matter sought to be patented and the prior art”, as that subject matter is defined by independent claim 11.
- which combination of specific teachings in the prior art render the “subject matter” of claim 11 when taken “as a whole” obvious?
- additionally, the Examiner’s reliance upon “Official Notice” is improper and unfairly denies the Appellant the ability to examine the body of knowledge upon which that Official Notice is based and to distinguish the pending claims over that body of knowledge because the Examiner is relying upon his personal knowledge. In accordance with 37 CFR §1.104(d)(2), the Examiner is respectfully requested to provide the Examiner’s affidavit and in that affidavit describe the data as specifically as possible, and to support that data with the

Examiner's affidavit, in order to accord the Appellant an opportunity to contradict or explain the patentability of these rejected claims over the data and reference relied upon by the Examiner in his "Official Notice."

Appellant submits that the *combination* of having a print agency electronically connected to a customer's computer terminal via the internet, the print agency being able to print at a remote location, and the fact that editing takes place at the internet print agency is not old and well known in the art and it is not taught nor suggested by the prior art, the *PR Newswire* is devoid of both a "print agency" and "editing by a print agency". Appellant submits that the notion that a traditional print shop may have editing services may not be relied upon in order to not infer that it is obvious under the "subject matter as a whole" criterion of 35 U.S.C. §103 to establish that the process defined by Appellant's claim 11 is rendered obvious by Farros '810. Moreover, the "distributed authoring and versioning" advocated by the *PR Newswire* may not be incorporated into the primary reference without impermissibly destroying the intended mode of operation of the primary reference because "distributed authoring and versioning" is the antithesis of both the function and operation of a "print agency" and of Appellant's "said printing agency editing said first draft" in combination with "generating a revised document based upon revisions to said first draft made by the customer." No matter how modified according to the Examiner's "Official Notice" of either editing or receiving an online estimate, Farros '810 is devoid of either teaching or suggestion for responding to Appellant's print request containing attributes of a printing job by issuing "a cost estimate" and then "receiving a first draft of a customer's printing job". Instead, Farros '810 simply obtains and allows the customer to change or modify the attributes of the printing job, and then allows the user to

verify those attributes; only then does Farros '810 discuss pricing and nowhere precedes the reception of the printing job with a cost estimate. Consequently, the proposed combination including Farros '810 is difficult and cumbersome for a user and requires that the printing job be completed before the user is given any inkling or notion of the cost. This requires to user to cancel the printing job and to re-start the printing job by selecting different menus, templates and modifications before the user is able to obtain the cost of the printing job. In contradistinction, claim 55 defines a process in which the attributes are first obtained, a cost estimate is readily issued and then the printing job itself is conveyed by the user to the agency and, unlike Farros '810, the user receives the benefit of editing by the agency, a feature wholly lacking and neither appreciated nor suggested by Farros '810. In view of these deficiencies in the Examiner's proposed combination of Farros '810, and the advantageous results flowing therefrom, claim 55 is patentably distinguishable and allowable over the prior art. Such action is respectfully requested.

Second, regarding claim 55, Appellant submits that the proposed combination including Farros '810 does not disclose a printing agency and Farros '810 does not disclose any Internet connection to a print agency via the Internet. In Farros '810, all of the software needed to produce the document to be printed, the print order and the payment and quote are all done at either the customer's personal computer or a kiosk. The only exception to this is FIG. 4 of Farros '810, where the customer connects to software for producing the document and placing the print order via the internet *in an office environment*. This requires that customer to incur the expense of obtaining and maintaining that software before undertaking a printing task, an

expense that a customer or user is able to avoid in the practice of Appellant's claim 55. Appellant submits that reference numeral 401 in Farros '810 is not a print agency but is merely a storage that can be accessed by others in the same office. Reference numeral 401 in FIG. 4 of Farros '810 is not an internet site with a web page or a home page as claimed by Appellant. The purpose of reference numeral 401 in FIG. 4 of Farros '810 is to avoid requiring each and every user in an office environment from having to store the software to produce the document and the storage of the document itself to be printed at a user's personal computer. FIG. 4 of Farros '810 enables people in an office environment to access the software, not enabling the entire world wide web to access the software. Thus, it is submitted that FIG. 4 of Farros '810 does not have a home page and does not provide access to all internet users in the world wide web access to the software needed to create a document, to get a price quote or to submit a job order to a remote printer. In view of these distinctions and the noted benefits flowing therefrom, claim 55 is patentably distinguishable and allowable over the Examiner's proposed combination.

Third, the Examiner's proposed combination fails to make a *prima facie* showing of the obviousness of claim 55. In this Official Notice, the Examiner maintains that the step of receiving an online estimate is old and well known in the art. Appellant submits that receiving an on-line estimate in the context of Appellant's claim 55 is wholly absent from the Examiner's proposed combination of Farros '810 and Official Notice. Appellant states in claim 55 a customer at a computer connected to a print agency that provides editing and cost estimates for a print job that is then sent to a third, remote location for printing. Appellant submits that the

cost estimate in combination with the editing at the print agency is neither taught nor suggested by the prior art. These distinctions may not be ignored in making a determination of obviousness.

Fourth, claim 55 defines an editor at the print agency edits the customer's draft. The Examiner states that column 2, lines 25-30 and column 10, lines 62-67 of Farros '810 teach this limitation. Appellant notes that Farros '810 does teach having the customer, as distinguished from Appellant's "print agency", at the customer's terminal to modify the document. Appellant submits however, that there is no editing in Farros '810 that is carried out at any print agency or by any other entity other than the user, or customer. When making a determination of obviousness *vel non*, the Examiner may not either arbitrarily gloss over the existence of Appellant's *customer* and *print agency* and their respective aspects defined by claim 55, nor mix those distinct aspects. In view of the complete failure of Farros '810 to either recognize the need for Appellant's allocation of the several features of a print manufacturing process to more parties than solely the user, and to address that need, claim 55 is patentably distinguishable and allowable over the prior art. The fact that both the Examiner and Farros '810 have failed to appreciate this allocation of labor, regardless of who performs which specific task, is evidence of the impropriety of this rejection as well as the non-obviousness of Appellant's process. Its withdrawal and allowance of claim 55 is required.

Fifth, Appellant submits that the editor in Appellant's claims needs to both be knowledgeable of editing skills that were in existence before computers and the internet and must also be knowledgeable of computer software, of digital imaging, of printing, and of the

internet and much more, a combination of skills that did not exist in the past, making this fifth limitation neither taught nor suggested by the prior art. Furthermore, the editor, unlike the customer, specializes in electronic file and image editing, a feature that is not old and well known in the prior art. The customer does not have these skills because the customer does not specialize in these areas. Therefore, the notion of having an editor edit a document that contains text and images is not taught nor fairly suggested by the prior art.

B. The Examiner Failed To Consider The Subject Matter Of Rejected Claims 38 through 44 As A Whole.

Under U.S. practice, a patent must be issued to an Appellant unless,

“the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made”¹⁰⁵

The Examining Staff has sought to examine these claims piecemeal, by asserting that various, diverse references, could be argued to teach various constituent components of these claims, and where the primary and secondary references were admitted by the Examining Staff to be lacking, the proposed combination relied upon “Official Notice” to supply the missing constituent component. Specifically, the Examiner’s proposed combination improperly paraphrased and abbreviated the rejected claims. As one exemplar of this impropriety, the Examiner asserts that the proposed combination teaches “receiving at said printing agency a first draft of a customer’s print job over the Internet”. In actuality however, the rejected claims expressly define a process step of “receiving at said printing agency, *subsequent to issuing said*

¹⁰⁵ 35 U.S.C. §103(a).

cost estimate, a first draft of a customer's print job *corresponding to said cost estimate ...*."

In short, the Examiner has improperly failed to consider the subject matter claimed "as a whole", in accordance with 35 U.S.C. §103(a). The rejection is therefore improper, and must be withdrawn.

Rejection of Claims 58-59 and 63 Under 35 U.S.C. §103(a)

Claims 58-59 and 63 are rejected under 35 U.S.C. §103(a) for alleged unpatentability over the Examiner's proposed combination of Farros '810 modified in view of Official Notice, the PR Newswire press release and Chabrow. Appellant respectfully traverses this rejection for the following reasons.

The Examiner again inaccurately, and improperly asserts that "Farros suggest[s] incorporating and editing step comprising correcting misspelling, correcting typographical errors" The Examiner's reference to column 3, lines 10-14 is widely inaccurate and misleading. Moreover, the Examiner's proposed combination fails to remedy the deficiencies noted in the rejection of parent claim 55. Accordingly, withdrawal of this rejection is required.

CONCLUSION

As demonstrated in the foregoing paragraphs, the eleven art rejections under 35 U.S.C. §103(a) are incomplete, lack a *prima facie* showing of obviousness under 35 U.S.C. §103(a) , fail to conform with the practice under 35 U.S.C. §103(a) to identify the differences between the subject matter claimed and the prior art, fail to consider *the subject matter as a whole* as instructed by 35 U.S.C. §103(a), are premised upon inaccurate and misleading paraphrases found only in Paper No. 29 rather than in the claims before the Board, depend upon proposed combinations of the art even though the record before the Board is devoid of evidence of the motivation necessary to may the combinations proposed, require modification of the primary reference in a manner which impermissibly prevents the primary reference from operating in its intended mode, and depend upon attribution of fictitious teachings to the applied art. These rejections should not therefore, be sustained. Such action is respectfully requested.

Respectfully submitted,



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IX. APPENDIX

CLAIMS UNDER APPEAL (Claims 38-81)

1- 37. (Cancelled)

6 38. (Previously Presented) An apparatus for printing, the apparatus comprising:

7 a server with a corresponding home page accessible through the Internet, said server
8 receiving a cost request through the Internet from a user, the cost request including a request
9 for an estimate of a cost of a print job and including identification data corresponding to the
10 user, the cost request including first data about the print job;

11 a first memory unit storing the cost request and the identification data received from said
12 server, said first memory unit being in communication with said server;

13 said server sending a cost estimate through the Internet to a destination corresponding
14 to the identification data, the cost estimate being generated in dependence upon the received
15 cost request, the cost estimate including a password and the estimate of the cost of the print job,
16 said server receiving the password and print data through the Internet from the user when the
17 user receives and approves the cost estimate, the print data being the information to be recorded
18 on recordable media;

19 an editing unit being in communication with said server, said editing unit editing the
20 print data received by said server through the Internet from the user when the print data is not
21 in a final form, said editing unit being distinguishable from the user;

22 a second memory unit storing the print data when the print data is in the final form, said

23 second memory unit being in communication with said editing unit; and

24 an output device receiving the print data in the final form from said second memory unit,
25 and recording the print data in the final form on the recordable media.

6 39. (Previously Presented) The apparatus of claim 38, the identification data
7 corresponding to an e-mail address of the user, the editing performed by said editing unit
8 including correcting spelling errors.

6 40. (Previously Presented) The apparatus of claim 39, said output device corresponding
7 to a selected output device selected from among a plurality of available output devices, the
8 selected output device being the output device geographically nearest to the user, said output
9 device receiving the print data through the Internet from said second memory unit.

6 41. (Previously Presented) The apparatus of claim 40, said server sending the edited
7 print data through the Internet to the user after said editing unit performs the editing of the print
8 data, the user receiving the edited data through the Internet and revising the edited print data
9 and sending the revised print data to said server, said editing unit further revising the revised
10 print data received by said server from the user to place the revised print data in the final form.

6 42. (Previously Presented) The apparatus of claim 41, said editing unit generating the
7 cost estimate.

6 43. (Previously Presented) The apparatus of claim 38, said server sending the edited
7 print data through the Internet to the user after said editing unit performs the editing of the print
8 data, the user receiving the edited data through the Internet and revising the edited print data
9 and sending the revised print data to said server, said editing unit further revising the revised
10 print data received by said server from the user to place the revised print data in the final form.

6 44. (Previously Presented) The apparatus of claim 43, the cost request including a name
7 of the user, the destination, a number of pages of the print job, a number of copies of the print
8 job, a type of binding of the print job, and a type of recordable media of the print job.

6 45. (Previously Presented) An Internet printing apparatus, comprising:
7 a printing agency, comprising a server disseminating a home page that, in response to
8 an inquiry by a customer over the World Wide Web, provides instructions explaining how a
9 customer can request an estimation of cost of a print job and enables a customer to select and
10 to modify attributes of said print job, said home page further comprising a form that may be
11 accessed through a hyperlink, said form enabling a customer to request said print job of a first
12 draft received from the customer;

13 said printing agency comprising a memory storing a customer's choice of attributes for
14 said print job and, subsequent to delivery of said estimation to the customer, storing a first draft
15 of said print job composed by the customer independently of said printing agency as a work that

16 is textually distinct from said attributes and that is received from the customer via the World
17 Wide Web;

18 said printing agency comprising an editor connected to said memory to edit said first
19 draft of said print job to create a first revision of said first draft to enable said customer to
20 receive said first revision via the World Wide Web, and to receive from the customer via the
21 World Wide Web, a second draft prepared by the customer in dependence upon said first
22 revision, and to generate a finalized version in dependence upon said second draft;

23 said memory being connected to said editor and storing said finalized version of said
24 print job; and

25 an output device connected to said memory via a network printing to download said
26 finalized version onto a recording media at a location that is geographically compatible with the
27 customer's choice.

6 46. (Previously Presented) The apparatus of claim 45, wherein said customer's first draft
7 and said finalized version of said print job comprises text, images and pictures.

6 47. (Previously Presented) The apparatus of claim 45, further comprised of said server
7 generating said estimation based upon said attributes comprised of:

8 size of paper to be printed;

9 color of paper to be printed;

10 quality of paper to be printed;

11 quantity to be printed;
12 whether or not to print a finished cover page has been selected;
13 whether or not binding of each document printed as being indicated and a type of binding
14 selected; and
15 type and location of said output device designated by the customer.

6 48. (Previously Presented) The apparatus of claim 45, further comprised of said server
7 enabling a customer to instruct said output device to download said finalized version to a
8 recording medium selected from among the group comprising a toner type digital printer, a CD-
9 ROM printing device, an ink-jet type printer, and a magnetic optical disk read/write device.

6 49. (Previously Presented) The apparatus of claim 46, further comprised of said server
7 enabling a customer to instruct said output device to download said finalized version to a
8 recording medium selected from among the group comprising a toner type digital printer, a CD-
9 ROM printing device, an ink-jet type printer, and a magnetic optical disk read/write device.

6 50. (Previously Presented) The apparatus of claim 45, further comprised of said output
7 device being selected from the group consisting of a toner type digital printer, a CD-ROM
8 printing device, an ink-jet type printer; and a magnetic optical disk read/write device.

6 51. (Previously Presented) The apparatus of claim 45, further comprised of said output

7 device comprising a plurality of devices including a toner type digital printer, a CD-ROM
8 printing device, an ink-jet type printer, and a magnetic optical disk read/write device.

6 52. (Previously Presented) The apparatus of claim 45, comprised of said editor making
7 changes to said first draft submitted by said customer over said Internet to said first memory,
8 said changes include changes specified by said customer and changes initiated by said editor.

6 53. (Previously Presented) The apparatus of claim 45, comprised of said editor
7 correcting misspellings in said first draft, correcting typographical errors in said first draft, and
8 correcting unreadable characters due to different software computer programs and different font
9 environment.

6 54. (Previously Presented) The apparatus of claim 45, wherein said output device prints
7 180 sheets per minute.

6 55. (Previously Presented) A method for printing text, images and pictures, comprising
7 the steps of:

8 connecting, via the Internet, a customer at a computer terminal to a printing agency;

9 driving a server integrated into said printing agency, to solicit from the customer via the
10 computer terminal a selection of a plurality of attributes about a print job;

11 receiving a print request form containing said attributes over the Internet at said printing

12 agency;

13 in response to reception of said print request form, said printing agency issuing a cost
14 estimate from said printing agency in dependence upon information contained in said print
15 request form;

16 receiving at said printing agency, subsequent to issuing said cost estimate, a first draft
17 of a customer's print job corresponding to said cost estimate and comprising text, images and
18 pictures textually distinct from said attributes from said customer's computer to said printing
19 agency over the Internet and storing said first draft in a first memory of said server;

20 said printing agency editing said first draft of said customer's print job at said print
21 agency, providing said first draft to the customer, and generating a revised document based on
22 revisions to said first draft made by the customer; and

23 outputting said revised document from a second memory to a remote output device of
24 the customer's choice.

6 56. (Previously Presented) The method of claim 55, comprised of obtaining said
7 attributes from the customer by driving said server to ask the customer to select a number of
8 pages in said first draft, a quantity to be printed, a paper size, whether or not a cover is to be
9 made, and whether or not each document is to be bound.

6 57. (Previously Presented) The method of claim 56, comprised of driving said server to
7 ask the customer to select the color and quality of the paper to be printed, the type of binding

8 if any, the location of where said revised document is to be printed, and the type of output
9 device selected by the customer to print the documents.

6 58. (Previously Presented) The method of claim 55, comprised of editing said first draft
7 by:
8 correcting misspellings in said first draft;
9 correcting typographical errors in said first draft; and
10 correcting unreadable characters due to different computer software programs or
11 different font environment.

6 59. (Previously Presented) The method of claim 58, wherein said editing step is further
7 comprised of formatting page margins, line spacing, font size, page numbering, line numbering,
8 and paragraph numbering.

6 60. (Previously Presented) The method of claim 55, wherein said editing step is
7 comprised of enlarging or reducing images and pictures of said first draft of said customer's
8 print job.

6 61. (Previously Presented) The method of claim 55, wherein said editing step is
7 comprised of the steps of:
8 conducting a first editing by said printing agency of said first draft of said customer's

9 print job;

10 returning an edited said first draft of said print job to the customer over the Internet;

11 accommodating further revisions to said print job made by said customer;

12 returning a revision of said print job back to the printing agency;

13 responding to reception of said revision by said printing agency by editing said revision

14 to produce a finalized document; and

15 storing said finalized document in said second memory at said printing agency.

6 62. (Previously Presented) The method of claim 55, wherein said output device can be
7 a toner type digital printer, a CD-ROM printing device, an ink-jet printer or a magnetic optical
8 disk read/write device.

6 63. (Previously Presented) The method of claim 55, further comprised of locating a first
7 plurality of output devices at a second plurality of locations distant from said printing agency,
8 said first plurality of output devices being connected by network to said second memory of said
9 printing agency.

6 64. (Previously Presented) A system for printing a document having text, images and
7 pictures, comprising:

8 a printing agency comprising a server accessible via the Internet, said server providing
9 a port accommodating transmission of information between said print agency and computers

10 of users accessing the Internet;

11 said printing agency comprising an editor editing a manuscript composed by a
12 corresponding one of the users independently of said printing agency with at least one of text,
13 image and pictural components and submitted by the corresponding one of the users to said
14 printing agency to produce the document, said printing agency returning a first draft of said
15 document to the corresponding one of the users, and disposed to generate a final draft of said
16 document in response to reception of a revision of said first draft from the corresponding one
17 of the users; and

18 a first plurality of output devices located at a second plurality of locations distant from
19 said printing agency, each of said first plurality of output devices connected to said printing
20 agency via computer network printing.

6 65. (Previously Presented) The system of claim 64, said printing agency comprises:

7 a first memory storing a manuscript originally submitted by said user prior to editing;

8 and

9 a second memory storing said document after editing.

6 66. (Previously Presented) The system of claim 64, wherein a second plurality of users

7 are transmitting and receiving data and revisions of a plurality of manuscripts simultaneously

8 from said printing agency.

6 67. (Previously Presented) The system of claim 64, wherein said first plurality of output
7 devices comprise:

8 toner type digital printers;

9 CD-ROM printing devices;

10 ink-jet type printers; and

11 magnetic optical disk read/write devices.

6 68. (Previously Presented) The system of claim 64, wherein said first plurality of output
7 devices print at a rate of 180 sheets per minute.

6 69. (Previously Presented) The method of claim 55, an editor that does said editing also
7 determines the cost estimate at the print agency for the customer, said editor being a separate
8 entity than said customer.

6 70. (Previously Presented) The method of claim 55, an editor that does said editing
7 being specialized in digital imaging, computer software, the internet and preparing a document
8 having text and images for print.

6 71. (Previously Presented) The apparatus of claim 45, said editor having access to
7 apparatus for monitoring and modifying text and images submitted by said customer to said
8 editor over the world wide web.

6 72. (Previously Presented) A system, comprising:

7 a printing agency having a web page accessible by a plurality of customers via the
8 internet, enabling the customers to specify attributes for manufacturing a publication of a
9 document created by a customer and enabling said customer to obtain from said printing agency
10 a price quote via the Internet for manufacturing the publication by said printing agency;

11 an editor at said printing agency receiving the document from the customer, and then
12 monitoring, evaluating and modifying the document created by said customer, storing a
13 modification of the document in a second memory at said printing agency, returning the
14 modification to the customer via the Internet, and enabling the customer to revise said
15 modification and to return a revised document to said printing agency via the Internet; and

16 a plurality of output devices located at a corresponding plurality of locales distant from
17 said print agency, each of said plurality of output devices connected to said print agency by a
18 computer printing network, each of said plurality of devices selectably used by the user to
19 manufacture the publication based upon the revised document.

6 73. (Previously Presented) The system of claim 72, with said attributes comprising the
7 number of copies to be printed and the media to be printed during said manufacturing.

6 74. (Previously Presented) The system of claim 72, said editor being a different entity
7 than said customer.

6 75. (Previously Presented) A method of printing, said method comprising the steps of:
7 accessing a home page of a print service through the Internet;
8 sending a cost request from a user through the Internet to the print service, the cost
9 request corresponding to a request for an estimate of a cost of a print job, the cost request
10 including first data about the print job;
11 when the cost request is received by the print service, storing the cost request;
12 generating a cost estimate in dependence upon the stored cost request, sending the cost
13 estimate through the Internet to the user, the cost estimate including identification data and
14 including the estimate of the cost of the print job;
15 when the user receives and approves the cost estimate, sending the identification data
16 and second data about the print job from the user through the Internet to the print service, the
17 second data including print data composed by the user independently of the print service to be
18 recorded on recordable media;
19 when the second data and the identification data are received by the print service, storing
20 the print data;
21 when the stored print data is not in a final form, performing a first editing of the stored
22 print data, the first editing being performed by an editor and not by the user;
23 storing the print data in the final form;
24 outputting the print data in the final form to a printing location;
25 recording the print data in the final form on the recordable media at the printing location;

26 and

27 receiving the recordable media bearing the print data.

6 76. (Previously Presented) The method of claim 75, said generating of the cost estimate
7 being performed by the editor, the first editing including correcting spelling errors.

6 77. (Previously Presented) The method of claim 76, the cost request including a name
7 of the user, the printing location, a number of pages of the print job, a number of copies of the
8 print job, a type of binding of the print job, and a type of recordable media of the print job.

6 78. (Previously Presented) The method of claim 77, the printing location corresponding
7 to a selected printing location selected from among a plurality of available printing locations,
8 the selected printing location being the printing location geographically nearest to the user, said
9 outputting of the print data to the printing location corresponding to outputting the print data
10 through the Internet to the printing location.

6 79. (Previously Presented) The method of claim 78, further comprising the steps of:
7 after the editor performs the first editing of the print data, sending the edited print data
8 through the Internet to the user;
9 when the user receives the edited print data, revising the print data, said revising being
10 performed by the user and not by the editor;

11 sending the revised print data from the user through the Internet to the print service; and
12 performing an additional editing of the print data to place the print data in the final form,
13 the additional editing being performed by the editor and not by the user.

6 80. (Previously Presented) The method of claim 79, said storing of the cost request
7 corresponding to storing the cost request at the print service, said storing of the print data
8 corresponding to storing the print data at the print service.

6 81. (Previously Presented) The method of claim 75, further comprising the steps of:
7 after the editor performs the first editing of the print data, sending the edited print data
8 through the Internet to the user;
9 when the user receives the edited print data, revising the print data, said revising being
10 performed by the user and not by the editor;
11 sending the revised print data from the user through the Internet to the print service; and
12 performing an additional editing of the print data to place the print data in the final form,
13 the additional editing being performed by the editor and not by the user.